

## Federal Court and Trademark Trial and Appeal Board Review

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\* In the interest of full disclosure, the author notes his participation or that of his law firm in the following cases referenced by this outline: *Abitron Austria GmbH v. Hetronic Int'l, Inc.*, 600 U.S. 412 (2023) (counsel of record for amicus curiae Intellectual Property Owners Association in support of neither party); *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023) (post-appeal counsel for counterclaim plaintiff); *Smoothie King Franchises, Inc. v. Best Smoothie, Inc.*, No. 1:21-CV-04402-WMR, 2024 WL 5104536 (N.D. Ga. Nov. 15, 2024) (counsel for plaintiff); *Rolex Watch U.S.A., Inc. v. Jewelry Unlimited, Inc.*, 757 F. Supp. 3d 1342 (N.D. Ga. 2024) (counsel for plaintiff); *D.H. Pace Co. v. OGD Equip. Co.*, No. 1:20-CV-410-TCB, 2024 WL 3551123 (N.D. Ga. May 30, 2024); *Hangzhou Mengku Tech. Co. v. Shanghai Zhenglang Tech. Co.*, 2024 U.S.P.Q.2d 2220 (T.T.A.B. 2024) (counsel for applicant); *MyMeta Software, Inc. v. Meta Platforms, Inc.*, 2024 U.S.P.Q.2d 780 (T.T.A.B. 2024) (counsel for applicant).

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## I. ESTABLISHING PROTECTABLE TRADEMARK AND SERVICE MARK RIGHTS

### A. Proving Protectable Rights Through Federal Registrations

1. In a case in which the parties claimed prior rights to the same unregistered mark, the Fourth Circuit confirmed that each was obligated to prove the mark's distinctiveness, even if they agreed between themselves the mark was valid:

We agree with the district court's sound conclusion that the competing trademark ownership and trademark infringement claims require each party to prove non-genericness. It is well-established that a party claiming ownership of an unregistered trademark bears the burden of proving that it owns a valid and protectable mark. And to show that the mark is valid and protectable, the party claiming ownership must show that the mark is distinctive.

*Moke Am. LLC v. Moke Int'l Ltd.*, 126 F.4th 263, 284 (4th Cir. 2025) (citation omitted).

2. Courts took different approaches to the effect of registrations on the Principal Register for which no declarations of incontestability under 15 U.S.C. § 1065 (2024), had been filed.
  - a. Consistent with the majority rule, some courts held that the “prima facie evidence” represented by a registration for which a declaration of incontestability has not yet been filed under 15 U.S.C. §§ 1057(b), 1115(a) (2024), affirmatively shifts the burden of *proof* on mark validity from the plaintiff to the defendant; the defendant therefore must establish by a preponderance of the evidence that the registered mark is invalid. *See, e.g., PSM Holdings LLC v. Tiny Town LLC*, No. 3:24-CV-05579-TMC, 2025 WL 623673, at \*13 (W.D. Wash. Feb. 26, 2025) (“If a plaintiff shows federal registration of a mark, the burden shifts to the defendant to show that ‘the mark is not protectable.’” (quoting *Zobmondo Ent., LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir. 2010))); *Weems Indus. v. Teknor Apex Co.*, 757 F. Supp. 3d 854, 914 (N.D. Iowa 2024) (“Because [the plaintiff's] mark . . . is listed on the Principal Register, [the defendant] bears the burden of proving that the mark is not valid and protectable.”); *Crye Precision LLC v. Concealed Carrier, LLC*, 749 F. Supp. 3d 308, 327 (E.D.N.Y. 2024) (“When a plaintiff sues for infringement of a trademark that is registered, the burden shifts to the defendant to rebut the mark's protectability.”).

- b. In contrast, the Seventh Circuit adhered to its traditional rule (albeit in a nonprecedential opinion) that prima facie evidence of validity can be rebutted through the mere production of evidence of invalidity. *See Jergenson v. Inhale Int’l Ltd.*, No. 24-1177, 2024 WL 4430531, at \*4 (7th Cir. Oct. 7, 2024).

## **B. Proving Common-Law Rights**

### **1. Proving Use in Commerce**

For the most part, use in commerce is a prerequisite for protectable rights to a trademark or service mark under the Lanham Act’s private causes of action, *see* 15 U.S.C. §§ 1114, 1125(a), 1125(c) (2024); except where non-U.S. applicants relying on foreign filings are concerned, a showing of use in commerce also is necessary to secure a federal registration. *See id.* §§ 1051(a)–(b). “Stated differently, ‘there can be no trademark absent goods sold and no service mark without services rendered.’” *In re 96 Wythe Acquisition, LLC*, No. 21-22108 (SHL), 2025 WL 1326844, at \*6 (Bankr. S.D.N.Y. May 7, 2025) (quoting *Am. Express Co. v. Goetz*, 515 F.3d 156, 161 (2d Cir. 2008)).

- a. The plaintiff in an appeal to the Fifth Circuit failed to defend its demonstration to the district court’s satisfaction that it had used its claimed unregistered APPLIANCE LIQUIDATION mark in commerce. *See Appliance Liquidation Outlet, L.L.C. v. Axis Supply Corp.*, 105 F.4th 362 (5th Cir. 2024). There was no dispute that the plaintiff had for over two decades operated a business featuring the following exterior signage:



*Id.* at 371. The plaintiff adduced testimony at trial from an employee that she sometimes answered the phone using “Appliance Liquidation” and identified her employer using the same words; moreover, the court added, “one of [the plaintiff’s] owners testified that advertisements would ‘either say Appliance Liquidation [sic] or Appliance Liquidation Outlet.’” *Id.* at 374. Nevertheless, the court concluded, “both witnesses made clear that ‘Appliance Liq-

liquidation’ was a shorthand for [the plaintiff’s] actual name— ‘Appliance Liquidation Outlet.’ The record does not contain any specific instance of [the plaintiff’s] using ‘Appliance Liquidation’ intentionally to identify its store.” *Id.* Although reluctant to overturn the district court’s finding of use in commerce, the court of appeals therefore was left with “a definite and firm conviction that the district court committed a mistake.” *Id.*

- b. The Fourth Circuit confirmed that a plaintiff claiming priority of rights to a particular mark need not demonstrate that its use of the mark was continuous, so long as any discontinuance of use did not rise to the level of abandonment. *See Simply Wireless, Inc. v. T-Mobile US, Inc.*, 115 F.4th 266, 283–85 (4th Cir. 2024), *cert. denied*, No. 24-367, 2025 WL 1020361 (U.S. Apr. 7, 2025). “Put simply,” the court explained, “when common law ownership of a trademark has accrued, those rights persist until — and unless — they are legally abandoned.” *Id.* at 284.

## 2. Proving Distinctiveness

- a. Findings of genericness for claimed color marks are rare, but the Federal Circuit affirmed just such a determination by the Trademark Trial and Appeal Board in *In re PT Medisafe Techs.*, No. 2023-1573, 2025 WL 1226471 (Fed. Cir. Apr. 29, 2025). The applied-for mark at issue was the color green for chloroprene medical examination gloves, as shown below in the applicant’s drawing and the specimen supporting its application:



*Id.* at \*1. In declining to disturb the Board’s finding that the claimed mark was unprotectable and unregistrable, the court endorsed the Board’s use of the following two-part inquiry: (1) what is the genus of the goods and services at issue; and (2) does the relevant public understand the claimed color primarily to refer to that genus of goods or services? *Id.* at \*4.

- i. With respect to the first of these inquiries, the court held that the Board had properly found the relevant genus of goods to be “chloroprene medical examination gloves” in-

stead of “chloroprene medical gloves *sold only to authorized resellers*” as proffered by the applicant. *Id.* at \*5.

- ii. It next held with respect to the second inquiry that substantial evidence supported the Board’s finding that the claimed mark “‘is so common in the chloroprene medical examination glove industry that it cannot identify a single source’ and is, therefore, generic.” *Id.* A significant showing by the examiner to that effect was “extensive third-party use of chloroprene/neoprene medical examination gloves in the same or nearly the same dark green color as in [the] proposed mark.” *Id.* (alteration in original). Although the applicant sought to rebut that showing through consumer declarations and survey evidence, the former were few in number, identical in form, and conclusory, while the latter arose from a methodology with numerous flaws and devised by the applicant’s counsel instead of a qualified expert. *Id.*
- b. The Federal Circuit also confirmed that “[a]cquired distinctiveness is a fact that must be determined on the entire record, and establishing that property is harder when the term at issue is highly descriptive (as the Board found in this case) than when it is descriptive to a lesser degree.” *Heritage All. v. Am. Pol’y Roundtable*, 133 F.4th 1063, 1069 (Fed. Cir. 2025) (citation omitted). It did so in a case in which it affirmed the Trademark Trial and Appeal Board’s finding that an opposer’s claimed “iVoterGuide” and “iVoterGuide.com” mark qualified as highly descriptive when used in connection with online voter guides.
- c. Having not surprisingly affirmed a finding that APPLIANCE LIQUIDATION OUTLET was a descriptive mark when used in connection with the retail sale of appliances, the Fifth Circuit also affirmed the district court’s determination that the mark had acquired the requisite distinctiveness necessary for it to qualify for protection. *See Appliance Liquidation Outlet, L.L.C. v. Axis Supply Corp.*, 105 F.4th 362 (5th Cir. 2024). In doing so, the court held that:

To determine whether a mark has acquired secondary meaning, courts consider the following seven factors: (1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer

testimony, and (7) the defendant’s intent in copying the mark.

*Id.* at 377 (quoting *Viacom Int’l v. IJR Cap. Invs., L.L.C.*, 891 F.3d 178, 190 (5th Cir. 2018)). The plaintiff did not adduce survey evidence under the fifth factor, *id.* at 379, and its proffered third-party articles under the fourth factor, *id.* at 378–79, but those failures were outweighed by its showings under the remaining factors. Those included two decades’ worth of the mark’s “sustained and striking use” on the exterior signage of the plaintiff’s building, *id.* at 377, sales of “about \$3.5 million” under the mark in a single year,” *id.* at 377–78, “evidence of advertising in amounts reasonable for a business of [the plaintiff’s] size,” *id.* at 378, direct testimony from a single consumer, *Id.* at 379, and the defendant’s apparent intentional copying of the plaintiff’s mark. *Id.* at 380 (“[The defendant’s] strikingly similar banner, coupled with its complete lack of a service infrastructure and its recent entry into the market, allows the district court to infer that [the defendant] intended to copy [the plaintiff’s] mark. At a minimum, it goes beyond mere awareness of [the plaintiff’s] mark or merely using the mark after the initiation of litigation.”). The court therefore affirmed the finding below that the plaintiff’s mark had acquired distinctiveness.

- d. The Fourth Circuit was more receptive than a district court—although only marginally so—to claims of distinctiveness of the alleged MOKE mark for motorized vehicles such as the following:



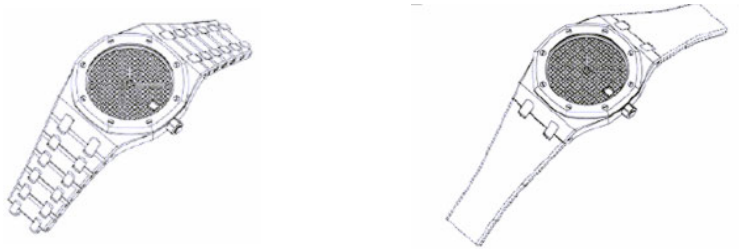
*See Moke Am. LLC v. Moke Int’l Ltd.*, 126 F.4th 263, 269 (4th Cir. 2025). Although the parties themselves did not dispute the mark’s validity—they both claimed rights to it in what otherwise was a priority dispute—the district court sua sponte concluded as a matter of law that “moke” was generic. The court of appeals did not consider the record sufficiently well-developed to support that determination, *id.* at 290, but it nevertheless held that the district court had properly imposed the burden on the parties to prove their respective versions of the claimed mark were not generic. *Id.* at 286.



- e. The Trademark Trial and Appeal Board has historically adopted a skeptical attitude toward the theory that once-generic terms can acquire trademark significance. *See, e.g., Cont'l Airlines Inc. v. United Air Lines Inc.*, 53 U.S.P.Q.2d 1385, 1395 (T.T.A.B. 1999) (“Even if one has achieved de facto acquired distinctiveness in a generic term through promotion and advertising, the generic term is still not entitled to protection because to allow protection would ‘deprive competing manufacturers of the product of the right to call an article by its name.’” (quoting *Am. Online Inc. v. AT&T Corp.*, 51 U.S.P.Q.2d 1865, 1873 (E.D. Va. 1999))). Nevertheless, the viability of that skepticism was called into question by the Federal Circuit’s holding in a cancellation action that a showing of genericness is necessary either at the time of registration or sometime afterwards; in other words, and at least in the registration context, a claimed mark that was generic prior to its owner beginning the registration process can be recovered from the public domain. *See Bullshine Distillery LLC v. Sazerac Brands, LLC*, 130 F.4th 1025, 1029 (Fed. Cir. 2025) (“[The counterclaim petitioner] argues if a term is generic at any time prior to registration, regardless of how it is understood at the time of registration, it remains generic for all time and cannot be registered. [The counterclaim respondent] argues the correct time period to assess if a mark was generic is at the time of registration. We agree with [the counterclaim respondent.]”).
- f. Tagged with jury findings of infringement and counterfeiting of a competitor’s product configurations after a ten-day trial, an electric guitar manufacturer and its holding company enjoyed better luck in an appeal to the Fifth Circuit. *See Gibson, Inc. v. Armadillo Distrib. Enters.*, 107 F.4th 441 (5th Cir. 2024), *as revised* (Aug. 8, 2024). The defendants intended to establish the genericness of the plaintiff’s claimed trade dresses at trial by relying on third-party uses of similar designs. Relying on the Federal Circuit’s opinion in *Converse, Inc. v. International Trade Commission*, 909 F.3d 1110 (Fed. Cir. 2018), however, the district court excluded the defendants’ evidence of third-party uses predating the defendants’ first use of their allegedly unlawful copies by more than five years. In reversing that decision, the Fifth Circuit noted that the Federal Circuit had held that “[third-party] uses older than five years should only be considered relevant if there is evidence that such uses were likely to have impacted consumers’ perceptions of the mark as of the relevant date.” *Gibson*, 107 F.3d at 448 (alteration in original) (quoting *Converse*, 909 F.3d at 1121). Because the district court had failed to consider the defendants’ argument that their proffered evidence might have had such an impact on consumer perception, that tribunal had abused its discretion in holding the evidence inadmissible. Moreover, that error was hardly a harmless one, for,

“at several periods in this litigation, the district court agreed that third-party-use evidence is highly relevant to the genericness analysis and the likelihood of confusion factors.” *Id.* at 441. The court of appeals therefore held the defendants entitled to a new trial. *Id.*

- g. A different case arising from the alleged copying of a guitar configuration also produced a temporary procedural stalemate. *See D’Pergo Custom Guitars, Inc. v. Sweetwater Sound, Inc.*, 111 F.4th 125 (1st Cir. 2024). The district court had found as a matter of law that the plaintiff’s configuration lacked acquired distinctiveness as a matter of law, and the court of appeals acknowledged “the wispiness of the [plaintiff’s] evidence.” *Id.* at 135. Nevertheless, that evidence consisted of testimony from three consumers that they had visited the defendant’s website and been confused by the appearance of the defendant’s guitar; moreover, the summary judgment record also contained testimony by “several” witnesses “that a person with knowledge of guitars can discern a guitar’s brand merely by the shape of its headstock.” *Id.* at 134. That was enough to create a factual dispute as to the distinctiveness of the plaintiff’s guitar, which mandated a vacatur and remand of the action for trial. *Id.* at 135.
- h. The Board adopted a skeptical view of an applicant’s showings of acquired distinctiveness for the following watch designs in *In re Audemars Piguet Holding SA*, 2025 U.S.P.Q.2d 18 (T.T.A.B. 2025):



*Id.* at \*1. Three aspects of the Board’s rejection of the promotional materials submitted by the applicant were noteworthy. First, and consistent with its past authority, the court gave those advertisements reduced weight because they did not reflect “look-for” advertising, which, in the Board’s estimation, required more than simply images of the watches. *Id.* at \*12–13. Second, the Board declined to consider seriously those advertisements depicting the applicant’s watches with elements in addition to those shown in its applications’ drawings. *Id.* at \*13–14. Finally, the Board found that:

[B]eyond the varying features themselves, most of the watches depicted in Applicant’s ads also display one or more of Applicant’s word marks . . . on the

watch faces. And the textual aspects of the ads feature Applicant's word marks . . . , as well. The presence in the ads of these word marks—which consumers are predisposed to view as source indicators—in ads that do not specifically call consumers' attention to the claimed design elements, detracts from the potential for Applicant's advertising to educate consumers to look to the design elements alone to identify source.

*Id.* at \*14 (citation omitted).

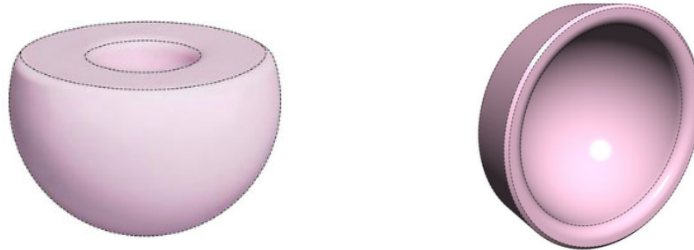
- i. Finally, although the Board and the Federal Circuit have in recent years gravitated toward the test first articulated in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977), when determining whether claimed nonverbal marks are inherently distinctive, the Board did not so in an opposition to an application to register the following mark for computer games and related software:



*Hangzhou Mengku Tech. Co. v. Shanghai Zhenglang Tech. Co.*, 2024 U.S.P.Q.2d 2220, at \*1 (T.T.A.B. 2024). Instead, the Board invoked the spectrum of distinctiveness applicable to word marks to find the mark merely descriptive of the associated goods.

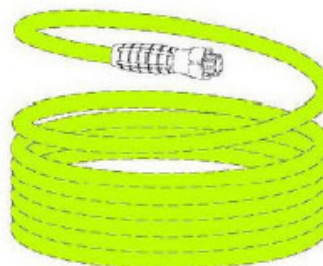
### 3. Proving Nonfunctionality

- a. The Federal Circuit affirmed a finding as a matter of law that the color pink was functional for hip implants made in part of chromium oxide. See *CeramTec GmbH v. Coorstek Bioceramics LLC*, 124 F.4th 1358 (Fed. Cir. 2025). It did so in a case presenting a challenge to registrations on the Supplemental Register of the following marks:



Chromium oxide is naturally pink, and the trial record included utility patents secured by the registrant touting the advantages of chromium oxide as a component of implants. *Id.* at 1364–65. That consideration was enough to carry the day for the challenger, even though the registrant had never advertised the utilitarian advantages of the color and despite the registrant’s claims that the challenger’s white implants functioned just as well and that its implants cost more to manufacture, the evidence of both of which the court determined was not as clear as the registrant characterized it. *Id.* at 1365–67.

- b. Consistent with that outcome, an Iowa federal district court reached a finding of functionality for the color chartreuse, which the plaintiff used and had registered on the Principal Register for hoses:



*See Weems Indus. v. Teknor Apex Co.*, 757 F. Supp. 3d 854, 868 (D. Iowa 2024). Unfortunately for the plaintiff, its advertising was replete with claims that its claimed mark made the hoses to which it was applied “more visible in the workplace,” *id.* at 867, and that “increase[d] visual awareness of the hose.” *Id.* at 8172. Having belatedly recognized that its claims of utilitarian advantage were inconsistent with its pretensions of trademark protection, the plaintiff scrubbed them from its promotional materials before applying to register its color, leading the court to find that:

[T]here is no evidence that [the plaintiff] received new information demonstrating that its safety-related advertising was false or misleading. Instead, [the plaintiff] learned that promoting [its] color as a safety feature was contrary to its efforts to obtain trademark protection for that color. . . .

....  
... In short, [the plaintiff] knew the color of its . . . hoses was a functional safety feature and proudly touted that fact until it decided to prioritize its efforts to obtain trademark protection for that color. It then attempted to “sanitize” its advertising and marketing materials and withheld them from the USPTO in order to achieve registration of its color mark.

*Id.* at 922, 923. Beyond that disappearing advertising, which the court found the plaintiff had concealed from the USPTO, the defendant successfully adduced expert witness testimony that chartreuse “one of the best design colors for visibility and that it has a longstanding use in making objects more visible.” *Id.* at 923. It also relied on utility patents “describ[ing] the utilitarian advantages of the color ‘chartreuse’ as a color that enhances visibility of an object,” *id.*, and a Federal Emergency Management Agency study finding that “Fluorescent colors (especially fluorescent yellow-green and orange) offer higher visibility during daylight hours.” *Id.* at 907. The plaintiff managed to introduce into the record evidence that certain industry participants used alternative colors, but the court found that “while this factor weighs slightly against a finding of functionality, this is not enough to outweigh the other factors which strongly weigh in favor of functionality.” *Id.* at 925.

- c. Although the Trademark Trial and Appeal Board typically examines the four factors set out in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982), when undertaking functionality inquiries, it held in *In re Audemars Piguet Holding SA*, 2025 U.S.P.Q.2d 18 (T.T.A.B. 2025), that those factors are not exhaustive. In particular, it held that “[w]here . . . the evidence overwhelmingly demonstrates widespread use of a design feature an applicant claims is a part of its trade dress, that feature is functional.” *Id.* at \*12.

## II. PROVING INFRINGEMENT AND UNFAIR COMPETITION

### A. Proving Likely Confusion

#### 1. Opinions Finding Confusion Likely

- a. The Fifth Circuit affirmed a finding of infringement in a case brought by the owner of the APPLIANCE LIQUIDATION OUTLET for mark for the retail sale of appliances against a competitor using the APPLIANCE LIQUIDATION mark. *See Appliance Liquidation Outlet, L.L.C. v. Axis Supply Corp.*, 105 F.4th 362 (5th

Cir. 2024). Those uses included the following presentations, which the court characterized as “strikingly similar” when discussing the acquired distinctiveness of the plaintiff’s mark:



*Id.* at 372, 380. Despite the perceived similarity in the parties’ uses, the district court found confusion likely based “entirely” on the plaintiff’s showing of actual confusion, *id.* at 381, and that finding survived scrutiny on appeal. The plaintiff’s showing on that point included

a log of interactions its employees had with consumers who believed [the plaintiff’s] store was affiliated with [the defendant’s]. That log detailed instances of consumers who called or came in person to ask for items [the defendant] posted about on social media. It also detailed multiple instances of customers’ asking [the plaintiff] to service products they had purchased from [the defendant].

*Id.* The defendant gamely argued the confusion was unrelated to its name, but the court would have none of it, concluding that “[t]he repeated and persistent flood of mistaken inquires by individuals . . . who believed [the plaintiff] was [the defendant] and vice versa occurred shortly after [the defendant] opened for business and shows that [the defendant’s] banner caused more than a fleeting mix-up of names.” *Id.* at 382. In the final analysis, “given the repeated instances of actual confusion presented at trial, the court permissibly found infringement on this digit alone.” *Id.*

- b. The Sixth Circuit affirmed a finding of liability in a case brought by the national Libertarian Party against dissenting members of the party holding themselves out as the national party's official Michigan affiliate. See *Libertarian Nat'l Comm., Inc. v. Saliba*, 116 F.4th 530 (6th Cir. 2024). The defendants' primary argument was that the use of the LIBERTARIAN PARTY mark in connection with the provision of political services—"for example, the maintenance of a website containing political platforms, endorsing candidates, and filing campaign finance reports," *id.* at 539—was non-commercial in nature and therefore nonactionable. Having rejected that proposition, the Sixth Circuit had little difficulty affirming the district court's conclusion on the national party's preliminary injunction motion that confusion was likely because of that use:

"If different organizations were permitted to employ the same trade name in endorsing candidates, voters would be unable to derive any significance from an endorsement, as they would not know whether the endorsement came from the organization whose objectives they shared or from another organization using the same name." Thus, we agree with the district court that defendants' use of the [national party's] trademark in connection with the provision of competing political services created a high likelihood of confusion for consumers, *i.e.*, potential voters, party members, and, in the case of solicitations not accompanied by a clear disclaimer, donors. *Id.* at 540 (quoting *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 90 (2d Cir. 1997)).

- c. The Seventh Circuit declined to disturb a jury verdict that the packaging trade dress for organic rolling papers in the top row below was infringed by the packaging in the bottom row:



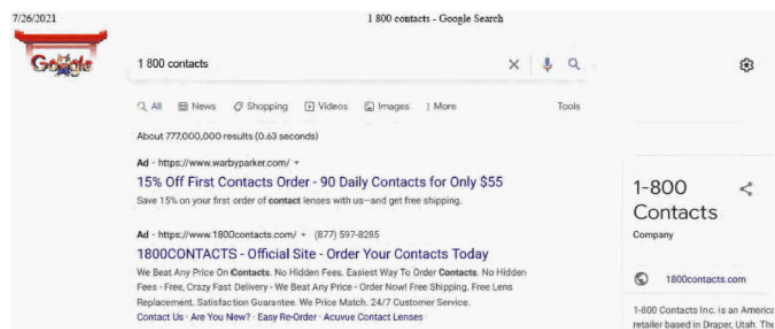




See *Republic Techs. (NA), LLC v. BBK Tobacco & Foods, LLP*, No. 23-2973, 2025 WL 1201401, at \*6 (7th Cir. Apr. 25, 2025). Beyond the similarity in the packages themselves, the counterclaim plaintiff's case benefitted from evidence in the trial record establishing the competitive proximity of the parties' goods, the impulse nature of purchases of them, anecdotal and survey evidence of actual confusion, and the counterclaim defendant's bad faith. *Id.* at \*7.

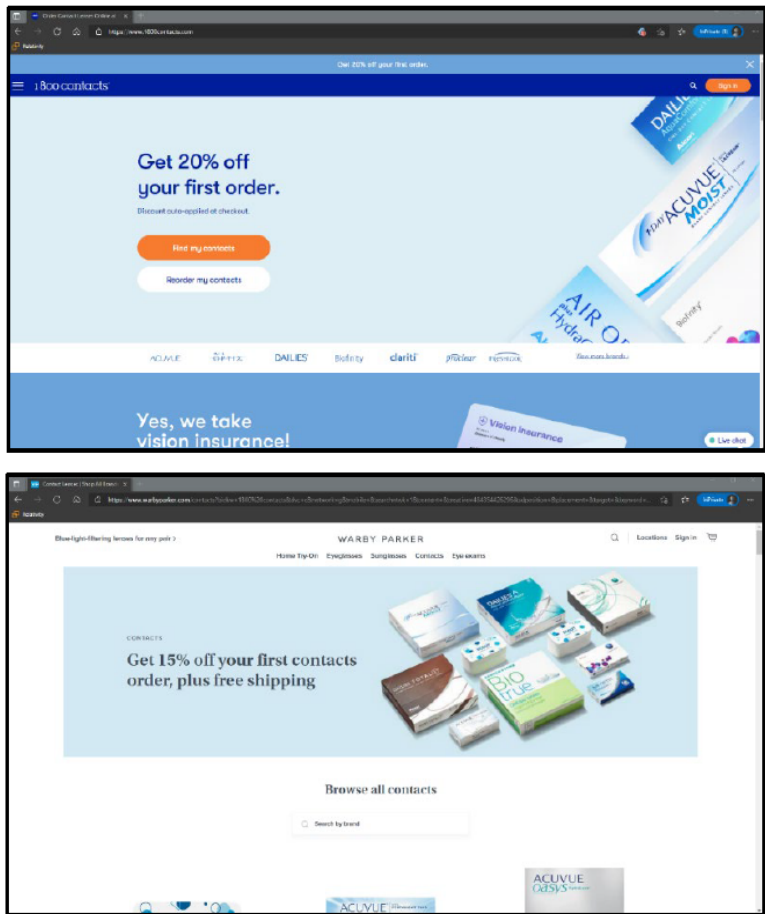
## 2. Opinions Finding Confusion Unlikely

- a. Two federal circuit courts of appeal rejected as a matter of law plaintiffs' claims that the purchase of their marks from Internet search engines as triggers for paid advertisements.
  - i. In the first, *1-800 Contacts, Inc. v. JAND, Inc.*, 119 F.4th 234 (2d Cir. 2024), the plaintiff sought to protect its flagship 1-800 CONTACTS mark for the online sale of contact lenses. 1-800 Contact's complaint included the following exemplar of how an advertisement for Warby Parker's competitive services appeared when consumers searched for 1-800 Contact's mark:



*Id.* at 242. According to 1-800 Contact, consumers accessing the link in the advertisement were taken to a deep linked page of Warby Parker's website that deliberately imitated the appearance of 1-800 Contact's website. For purposes of comparison, a screenshot of 1-800 Contact's site appears below in the top row, while one of Warby Parker's site appears in the bottom row:





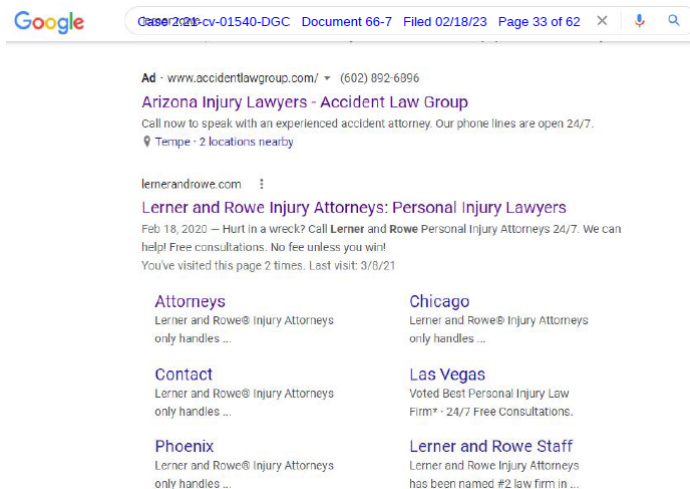
*Id.* at 243–44. Although acknowledging that a claim of likely confusion required a fact-intensive inquiry ordinarily not lending itself to disposition on a motion for judgment on the pleadings, *id.* at 255, the court found that the district court had properly granted just such a motion. Focusing on the absence of the 1-800 CONTACTS from Warby Parker’s deep linked landing page, the court explained that:

[T]he pleadings failed to plausibly allege that Warby Parker used 1-800’s Marks anywhere during the search advertising process outside of its purchase at the initial, permissible keyword auction. Notably, Warby Parker did not use 1-800’s Marks in the paid advertisement displayed on the search results page, in the domain name of the URL linked in the paid advertisement (www.warbyparker.com), or on the landing webpage displayed to consumers who clicked on the URL in the paid advertise-

ment. Nor did 1-800 plausibly allege that Warby Parker used any other protectable marks in these remaining components of the search advertising campaign. Thus, the dissimilarity of the marks factor is dispositive in this case; 1-800 has not adequately alleged likelihood of consumer confusion.

*Id.* (citation omitted). 1-800 Contacts was not helped by its failure to aver the existence of survey evidence or anecdotal evidence of actual confusion, *id.* at 252, even if the court held that the operative complaint successfully established the strength of its marks, the competitive proximity and relative quality of the parties' goods and services, and Warby Parker's bad faith. *Id.* at 249–50.

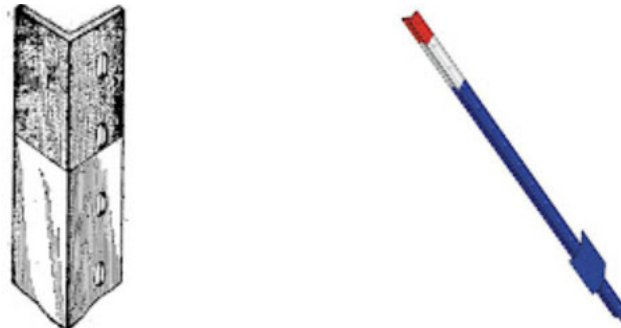
- ii. In the second case, *Lerner & Rowe PC v. Brown Engstrand & Shely LLC*, 119 F.4th 711 (9th Cir. 2024), the parties were competitive law firms, and the defendant had purchased the plaintiff's LERNER & ROWE mark as a keyword. Each of the advertisements challenged by the plaintiff, a representative example of which appears below, was labeled as one and appeared ahead of the "organic" search result for the plaintiff's firm:



*Id.* at 724. The district court entered summary judgment in the defendant's favor, and the Ninth Circuit affirmed. The plaintiff was not without likelihood-of-confusion factors weighing in its favor, including the strength of its mark, *id.* at 719, and at least some anecdotal evidence of actual confusion in the form of "236 phone calls that [the defendant's] intake department received during which the caller mentioned [the plaintiff] by name when responding to a ques-

tion about how the caller found [the defendant's] phone number. *Id.* But the court determined that the number of proffered phone calls was de minimis and, in any case, was outweighed by survey evidence adduced by the defendant showing that only “between 0% and 3%” respondents were confused by the defendant’s advertisements. *Id.* at 720. It also concluded that “savvy online shoppers would be able to differentiate between the parties’ links on Google,” *id.* at 725, that the actual names of the parties’ firms were distinguishable, *id.* at 726, that the plaintiff had failed to identify any evidence that the defendant had acted with a bad faith intent to deceive (as opposed to an intent to compete. *Id.* In the final analysis, it held, “[t]he district court was correct to conclude that this is one of the rare trademark infringement cases susceptible to summary judgment.” *Id.*

- b. The Board found confusion unlikely in an opposition proceeding between the following color marks, both used in connection with fence posts (the opposer’s mark on the left was lined for the color red):



*See Keystone Consol. Indus. v. Franklin Inv. Corp.*, 2024 U.S.P.Q.2d 1425, at \*1 (T.T.A.B. 2024). Chief among the considerations driving that outcome were the conceptual and commercial weakness of the opposer’s mark, *id.* at \*9–14, and the distinguishable appearances of the parties’ marks when viewed in their entireties. *Id.* at \*14–19.

### 3. **Opinions Deferring Resolution of the Likelihood-of-Confusion Inquiry**

- a. In vacating and remanding a finding that confusion was unlikely solely because of the geographic distance between the physical facilities of the west coast-based plaintiff, a federal registrant, and those of the defendant, which operated on the east coast. *See Westmont Living, Inc. v. Ret. Unlimited, Inc.*, 132 F.4th 288 (4th Cir. 2025). The district court reached its determination of unlikely confusion by applying the *Dawn Donut* doctrine, *Dawn Donut Co.*

*v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959), but the court of appeals held that that doctrine may carry reduced force in the modern era:

*Dawn Donut* stands for a narrow and logical principle that where businesses use the same mark in physically distinct geographical markets and their marketing and advertising are confined to those geographical markets, a likelihood of confusion will not be created. . . .

. . . .  
. . . *Dawn Donut* . . . recognize[s] the commonsense proposition that when two local businesses operate with the same mark in entirely distinct geographical markets, including their advertising and marketing, a likelihood of confusion will not arise. But those circumstances are present far less frequently today, in light of increased mobility, the Internet, and the reduced influence of local radio and newspaper advertising.

*Id.* at 297, 298. The court therefore remanded the matter for a more robust consideration of all the factors that properly play a role in the likelihood-of-confusion inquiry, including the geographic markets from which the parties drew their customers. *Id.* at 299.

- b. In *Bureau Nat'l Interprofessionnel du Cognac v. Cologne & Cognac Ent.*, 110 F.4th 1356 (Fed. Cir. 2024), the opposers were responsible for administering the French government's common-law COGNAC mark, used to certify grape brandy distilled in the cognac region of that country. They challenged an application to register the following mark for various entertainment-related goods and services, only to fall victim to a Trademark Trial and Appeal Board finding of no likelihood of confusion:



*Id.* at 1363. The Board had required the opposers to demonstrate that their mark as famous for its “certification status,” *id.* at 1336; moreover, it also discounted the opposers’ evidence that their mark

was famous as a mark because the beverages certified to bear the mark also bore the marks of the parties certified by the opposers. The Federal Circuit held both approaches to be reversible error. With respect to the first, it held that “[n]ot only is there no statutory requirement that consumers be aware of the ‘certification status’ of the mark, but such a requirement could be impractical and inconsistent with ordinary purchasing behaviors.” *Id.* at 1336–67 (footnote omitted). And, with respect to the second, it observed that:

Certification marks are often present with a house or brand name mark because they can only be used on third-party products. The fame of a house mark therefore cannot, per se, preclude a finding of fame of a certification mark that appears on the same product. Nor is there a presumption that the fame of a product is the result of the house mark over the certification mark. Indeed, some products may be more famous for their regional origin, as indicated by their certification mark, than for their brand name, e.g., FLORIDA oranges, DARJEELING tea, and GEORGIA peaches. . . . That a brand name, e.g., HENNESSEY, may be famous does not mean the certification mark cannot also be famous. It is not an either/or situation.

*Id.* at 1367 (citations omitted). Because the Board had additionally erred in suggesting that the certification-mark nature of the COGNAC mark weighed against the likelihood of confusion with the applicant’s trademark, and in comparing the opposers’ certification services to the applicant’s goods and services—the proper comparison was between the goods of parties certified to use the opposers’ mark to the applicant’s goods and services—a vacatur and remand were appropriate. *Id.* at 1371–72.

## **B. Proving Passing Off and Reverse Passing Off**

As the Supreme Court has explained, “[p]assing off (or palming off, as it is sometimes called) occurs when a producer misrepresents his own goods or services as someone else’s. “Reverse passing off,” as its name implies, is the opposite: The producer misrepresents someone else’s goods or services as his own.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28 (2003).

1. One court held that “a reverse palming off claim requires allegations: ‘(1) that the [product] at issue originated with the plaintiff; (2) that [the] origin of the [product] was falsely designated by the defendant; (3) that the false designation of origin was likely to cause consumer confusion; and

(4) that the plaintiff was harmed by the defendant’s false designation of origin.”” *Portkey Techs. Pte Ltd. v. Venkateswaran*, No. 23-CV-5074 (JPO), 2024 WL 3487735, at \*9 (S.D.N.Y. July 19, 2024) (alterations in original) (quoting *Societe Des Hotels Meridien v. LaSalle Hotel Operating Partnership, L.P.*, 380 F.3d 126, 131 (2d Cir. 2004)). It did so in a case in which the gravamen of the plaintiffs’ reverse passing off claim was not entirely clear but apparently turned on the defendant’s allegedly false representations that he had been more involved in the development of two trademarks used by the plaintiff than he actually had been. That scenario, the court concluded in granting a motion to dismiss, did not support a claim for reverse passing off. *Id.* at 10.

2. Another court confirmed that “[r]everse palming off—a species of unfair competition—occurs when a company misappropriates another’s product by removing the original name or trademark and selling it under a new name.” *Cirrus ABS Corp. v. Strategic Am., Inc.*, No. 1:24CV251 DRL-SJF, 2024 WL 4554021, at \*4 (N.D. Ind. Oct. 22, 2024).

## **C. Proving Actual and Likely Dilution**

### **1. Proving Eligibility for Dilution Protection**

- a. Some marks were found famous under the restrictive standard set forth in Section 43(c)(2)(a) of the Lanham Act, 15 U.S.C. § 1125(c)(2)(A) (2024).
  - i. Those included the following mark for consumer lawn, garden, pesticide, and insecticide products, at least at the pleadings stage of the case brought to protect it:



*Scotts Co. v. SBM Life Sci. Corp.*, 749 F. Supp. 3d 865, 874–75 (S.D. Ohio 2024).

- ii. They also included the trademarks and trade dress associated with Jack Daniel’s flagship beverage:

Jack Daniel’s has spent hundreds of millions of dollars to promote Jack Daniel’s whiskey. Regarding sales, Jack Daniel’s has been the best-selling whiskey in the United States since 1997, exceeding 75 million cases and 10 billion dollars in sales. In terms of recog-

dition, Jack Daniel's trademarks have been used continuously for over a century, except during Prohibition. Jack Daniel's trademarks and trade dress have been viewed by millions of Americans in movies and television programs. Jack Daniel's is prominently featured as jackdaniels.com, which was visited more than four million times in 2014. Jack Daniel's trade dress is prominently featured on social media pages for the brand. Based on Jack Daniel's internal records, Jack Daniel's has achieved global recognition and aided consumer awareness of the Jack Daniel's brand is consistently around 98%.

*VIP Prods. LLC v. Jack Daniel's Props. Inc.*, No. CV-14-02057-PHX-SMM, 2025 WL 275909, at \*4 (D. Ariz. Jan. 23, 2025) (citations omitted).

- b. Nevertheless, other marks fell short of the high bar for mark fame.
  - i. For example, although enjoying local fame in the Houston market, the RUGGLES mark for restaurant services also failed to qualify for federal protection after the Fifth Circuit affirmed the dismissal of a claim that the mark qualified for protection under federal law. *See Molzan v. Bellagreen Holdings, L.L.C.*, 112 F.4th 323, 335 (5th Cir. 2024).
  - ii. Likewise, the MEDAIR mark for medical air mattresses also failed to make the grade. *See Med. Depot, Inc. v. Med Way Us, Inc.*, No. 22-CV-01272 (OEM) (SIL), 2025 WL 948334, at \*13 (E.D.N.Y. Mar. 28, 2025).

## 2. Proving Liability

- a. On remand from the Supreme Court's opinion earlier in the case, Jack Daniel's prevailed on its claim of likely dilution through tarnishment arising from its opponent's imitation to Jack Daniel's marks and trade dress as part of an alleged parody. *See VIP Prods. LLC v. Jack Daniel's Props. Inc.*, No. CV-14-02057-PHX-SMM, 2025 WL 275909 (D. Ariz. Jan. 23, 2025). In finding Jack Daniel's entitled to prevail, the district leaned heavily on expert testimony proffered by that company. *See id.* at \*6–7.
- b. Albeit in an unreported opinion, the Second Circuit affirmed a jury finding that the famous trade dress on the left for bourbon was

likely diluted by the trade dress on the right for a directly competitive beverage:



*See Diageo N. Am., Inc. v. W.J. Deutsch & Sons Ltd.*, No. 22-2106, 2024 WL 2712636 (2d Cir. May 28, 2024).

- c. One failed claim of likely dilution by blurring came, at least on the plaintiff's motion for summary judgment, came in a dispute between competing clothing manufacturers. *See Levi Strauss & Co. v. Connolly*, 721 F. Supp. 3d 987 (N.D. Cal. 2024). The fame of the plaintiff's marks was established by the defendant's failure to object or respond to the plaintiff's requests for admission on the issue, but the plaintiff's luck did not extend to the court's acceptance of its proposed test for likely blurring. Apparently eschewing an application of the statutory factors, the plaintiff argued (as summarized by the court) that "when the parties' respective products are competitive, the dilution analysis is similar to the test for likelihood of confusion under a traditional infringement analysis." *Id.* at 999. The court, however, properly noted that "the statute itself indicates that confusion and competition are irrelevant to a dilution claim," *id.*, and it therefore denied the plaintiff's bid for liability as a matter of law. *Id.* at 999-1000.

#### D. Proving Counterfeiting

1. In dismissing a federal counterfeiting cause of action for failure to state a claim, a California federal district court confirmed that ownership of a federal registration is a prerequisite for that cause of action. *See Bratt v. Love Stories TV, Inc.*, 713 F. Supp. 3d 847, 861 (S.D. Cal. 2024). Nevertheless, the court granted the plaintiff leave to replead its complaint to add allegations establishing the registered status of its mark. *Id.*



2. A Georgia federal district court confirmed that the material alteration of goods bearing a registered mark can render that mark a counterfeit even if the defendant making the alterations attempts to disclose their existence to consumers. *See Rolex Watch U.S.A., Inc. v. Jewelry Unlimited, Inc.*, 757 F. Supp. 3d 1342, 1362 (N.D. Ga. 2024).
3. In *People v. Kumar*, 220 N.Y.S.3d 126 (Ct. App. 2024), an intermediate New York appellate panel affirmed a trial court’s refusal to seal the criminal counterfeiting conviction of a petitioner who had gone on to “establish[] and run several multi-million dollar business ventures, thereby showing that the conviction has not served as a barrier to employment or opportunity or acted as an impediment to the rehabilitative effects of the criminal justice system.” *Id.* at 127. That the petitioner had had no other brushes with the law did not mandate a contrary conclusion, especially because “when the [petitioner] was asked about his offense, he attempted to minimize his conduct rather than taking responsibility for it.” *Id.*

## **E. Proving Cybersquatting**

The Anticybersquatting Consumer Protection Act (ACPA) authorizes both in rem and in personam actions in challenges to domain names that allegedly misappropriate trademarks and service marks. *See* 15 U.S.C. § 1125(d) (2024). If a prior arbitration proceeding under the Uniform Dispute Resolution Policy (UDRP) has resulted in the suspension, transfer, or disabling of a domain name, the ACPA also authorizes what is effectively a mechanism for the domain name registrant to appeal the outcome of the UDRP action by bringing a cause of action for reverse domain name hijacking. *See id.* § 1114(2)(D)(v).

1. In an action producing a predictable finding of cybersquatting, the lead plaintiff was a franchisor and owner of the MUFFLER MAN mark for automotive maintenance and repair services. *See Muffler Man Supply Co. v. TSE Auto Serv., Inc.*, 739 F. Supp. 3d 598 (E.D. Mich. 2024). During the pendency of a franchise agreement allowing the defendants to use that mark under license, the defendants registered and used the mufflerman-service.com domain name to promote their business. Upon the agreement’s termination, the defendants continued to use the domain name in connection with a new directly competitive company 2.3 miles from their location when operating as franchisees of the lead plaintiff, leading the lead plaintiff to pursue a temporary restraining order under the ACPA. The court held it entitled to that relief in a straightforward manner, holding that “[The plaintiff] has demonstrated that it is likely to establish that its trademark is valid and distinct, that [the defendants’] domain name is confusingly similar, and that ‘bad faith’ is likely present. Thus [the lead plaintiff] is likely to succeed on its ACPA claims.” *Id.* at 603 (citations omitted). Indeed, the court was sufficiently convinced of the lead plaintiff’s ultimate likelihood of success on the merits that it did not require the posting of a bond. *Id.* at 604–05.

2. Having prevailed in a prior UDRP preceding against the registrant of the lambo.com domain name, the manufacturer of LAMBORGHINI-branded automobiles not only successfully defended its victory in an action for reverse domain name hijacking brought by the registrant, but it did so as a matter of law. *See Blair v. Automobili Lamborghini SpA*, 754 F. Supp. 3d 849 (D. Ariz. 2024), *appeal docketed*, No. 24-6839 (9th Cir. Nov. 12, 2024). Although the registrant had never used the domain name in conjunction with an active website, he had ill-advisedly offered to sell it for prices ranging from \$1,129,298.00 to \$75 million. *Id.* at 854. He also did not help himself with the dubious claims that “he was drawn to the name ‘Lambo’ as a play on the word ‘Lamb,’ with an outlier generic aptitude and intelligence, hence ‘Lambo-O’ and [that] the name ‘Lambo’ ‘resonated with him on a personal level and perfectly encapsulated his identity and ethos.’” *Id.* at 857 (citation omitted).
3. Another in personam finding of liability came in a case in which, having encountered the AMPLIFY CAR WASH ADVISORS and AMPLIFY marks in the car-wash financial-services industry, the principal of a competitor of the owner of those marks rushed out and registered amplifycarwash.com as a domain name, which the defendants used to redirect visitors to their own site. *See Amplify Car Wash Advisors LLC v. Car Wash Advisory LLC*, No. 22-CV-5612 (JGK), 2025 WL 764373 (S.D.N.Y. Mar. 10, 2025). Not surprisingly, the plaintiff not only prevailed but did so as a matter of law. *Id.* at \*7–11.

### III. PROVING FALSE ADVERTISING

- A. Most courts applied the standard five-part test for false advertising over the past year, requiring plaintiffs to show: (1) a false or misleading description of fact or representation of fact by the defendant in a commercial advertisement about its own or another’s good or service; (2) the materiality of the misrepresentation; (3) actual or likely deception of a substantial segment of its audience; (4) placement of the misrepresentation in interstate commerce; and (5) actual or likely injury of the plaintiff, either by direct diversion of sales or by a lessening of goodwill associated with its products. *See, e.g., Rolex Watch U.S.A., Inc. v. Jewelry Unlimited, Inc.*, 757 F. Supp. 3d 1342, 1363 (N.D. Ga. 2024); *Haw. Foodservice All., LLC v. Meadow Gold Dairies Haw., LLC*, 736 F. Supp. 3d 909, 919 (D. Haw. 2024).
- B. As always, courts generally tied the prerequisite of actual or likely deception to the type of falsity demonstrated by plaintiffs.
  1. If the challenged advertising was not literally false, extrinsic proof of actual or likely deception was required. *See, e.g., In re HomeAdvisor, Inc. Litig.*, No. 16-CV-01849-PAB-KAS, 2024 WL 4187099, at \*12 (D. Colo. Sept. 13, 2024); *Sanho Corp. v. Kaijet Tech. Int’l Ltd., Inc.*, 736 F. Supp. 3d 1241, 1266 (N.D. Ga. 2024).

2. In contrast, a finding of literal falsity created a presumption of actual or likely deception. *See, e.g., SouthState Bank, N.A. v. Qoins Techs., Inc.*, 720 F. Supp. 3d 1324, 1341 (N.D. Ga. 2024) (“If the court deems an advertisement to be literally false, then the movant is not required to present evidence of consumer deception.” (quoting *Osmose, Inc. v. Viance, LLC*, 612 F.3d 1298, 1319 (11th Cir. 2010))).
- C. In an application of Tenth Circuit law, the Federal Circuit held that inaccurate claims that a product was “patented,” “proprietary,” and “exclusive” were actionable false advertising. *See Crocs, Inc. v. Effervescent, Inc.*, 119 F.4th 1, 2 (Fed. Cir. 2024). According to the court, “a cause of action [for false advertising] arises . . . where a party falsely claims that it possesses a patent on a product feature and advertises that product feature in a manner that causes consumers to be misled about the nature, characteristics, or qualities of its product.” *Id.* at 6–7.
- D. A filing for federal bankruptcy protection triggers an automatic stay on efforts by creditors of the debtor and others “to obtain possession of property of the estate or of property from the estate or to exercise control over property of the estate.” 11 U.S.C. § 362(a)(3) (2024). The proper interpretation of that statutory language took center stage in an appeal to the Second Circuit in a case in which the debtors accused a competitor of having engaged in false advertising aimed at siphoning off the debtors’ customers. *See In re Windstream Holdings, Inc.*, 105 F.4th 488 (2d Cir. 2024).
  1. The advertising in question called the debtors’ filing to the attention of consumers in the geographic markets serviced by the debtors to and advised them that the debtors’ future was “unknown.” *Id.* at 492. The debtors responded by successfully arguing to the bankruptcy court but unsuccessfully to the district court that the competitor’s advertising campaign had violated the automatic stay because the campaign had sought to appropriate the debtors’ goodwill in the form of their customer contacts.
  2. The Second Circuit held that the bankruptcy court had not erred in holding the competitor not in contempt of the automatic stay. It began its analysis of the issue by confirming both that the debtors’ contracts with their customers and that their goodwill constituted property of the bankruptcy estate. *Id.* at 497. Nevertheless, the court next held that the competitor had not unlawfully attempted to exercise control over that property:

The automatic stay exists to give debtors a “fresh start,” but not the “head start” that could result from allowing a debtor to prevent competition. Construing “exercise control” to include any action that affects consumer choice would prohibit any advertising (indeed, any competition) with a debtor during bankruptcy—an unimaginable result.

*Id.* at 498–99 (first quoting *In re Kokoszka*, 479 F.2d 990, 995 (2d Cir. 1973); and then quoting 11 U.S.C. § 362(a)(3)). The court therefore affirmed the district court’s finding of no contempt with the explanation that “[b]ecause we are skeptical that by its actions, [the competitor] ‘exercised control’ over [the debtors’] estate property under the Bankruptcy Code, we hold that there is, at least, a ‘fair ground of doubt’ that Charter violated the automatic stay.” *Id.* at 499 (quoting *Taggart v. Lorenzen*, 587 U.S. 554, 561 (2019)).

#### IV. PROVING RIGHT-OF-PUBLICITY VIOLATIONS AND FALSE ENDORSEMENT

- A. The owner of the MIDJOURNEY AI-branded generative AI platform failed, at least at the pleadings stage, to escape a class action lawsuit alleging false endorsement under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (2024), in which the plaintiffs accused Mid of using the plaintiffs’ artistic works as “training images” for its platform. *See Andersen v. Stability AI Ltd.*, 744 F. Supp. 3d 956 (N.D. Cal. 2024). The plaintiffs alleged that the defendant’s CEO had posted a list identifying 4,700 artists whose styles Midjourney could emulate and also that Midjourney had used their names in connection with Midjourney’s “showcase” of works generated on the platform. The court concluded that those allegations were sufficiently detailed to survive the pleadings stage of the case: “Whether or not a reasonably prudent consumer would be confused or misled by the [list of names] and showcase to conclude that the included artists were endorsing the Midjourney product can be tested at summary judgment.” *Id.* at 978.
- B. When a fashion model learned of her brief appearances in a documentary on Ralph Lauren and the trailer for it, she filed suit under New York’s statutory causes of action for violations of persona-based rights, N.Y. CIVIL RIGHTS LAW §§ 50, 51, on the theory that the documentary was a disguised advertisement for Lauren’s clothing. *See Khozissova v. Ralph Lauren Corp.*, 214 N.Y.S.3d 331 (App. Div. 2024). Neither the trial court nor a state appellate panel tasked with reviewing the trial court’s dismissal of her complaint found that claim convincing. To begin with, the latter tribunal pointed out, the statutes at issue did not reach coverage of newsworthy topics, which Lauren’s life and career “plainly” were, *id.* at 333; “[i]n fact,” it added, “courts have recognized the newsworthiness of publications and other works concerning the fashion industry.” *Id.* at 334. Beyond that, the plaintiff had appeared “for a total of 38 seconds over the course of the 108-minute documentary and for one second in the 90-second trailer,” *id.* which qualified the two appearances as nonactionable “isolated” or “fleeting or incidental” ones. *Id.* (quoting *Candelaria v. Spurlock*, No. 08 Civ. 1830(BMC)(RER), 2008 WL 2640471, at \*2 (E.D.N.Y., July 3, 2008)). The court therefore not only affirmed the dismissal of the plaintiff’s complaint but also declined to disturb the trial court’s award of attorneys’ fees to the defendant. *Id.*

## V. DEFENSES

### A. Legal Defenses

#### 1. Abandonment

Under Section 45 of the Lanham Act, 15 U.S.C. § 1127 (2024), trademark law contemplates two scenarios in which a mark owner can lose the rights to its mark through abandonment: (1) a discontinuance of use coupled with an intent not to resume use; and (2) conduct by the mark owner that causes the mark to lose its significance as an indicator of source, *e.g.*, the grant of so-called “naked licenses,” under which the mark owner does not control the nature and quality of the goods and services provided under the licensed mark.

##### a. Abandonment Through Nonuse

- i. The First Circuit reached a determination of abandonment through nonuse. *See To-Ricos, Ltd. v. Productos Avicolas Del Sur, Inc.*, 118 F.4th 1 (1st Cir. 2024). The court did so in a case in which a declaratory judgment defendant had failed to use its mark for more than three years after a lender had frozen the defendant’s financing. The district court found abandonment as a matter of law, and the First Circuit affirmed.

- (A) As a threshold strategy, the defendant invoked its dispute with the lender as support for the proposition that its putatively excusable nonuse prevented Section 45’s three-year clock from running. The court rejected that theory with the observation that:

The Lanham Act means what it says: “Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” The text does not distinguish between inexcusable and excusable years of nonuse. Indeed, the statute is agnostic about the reason for a mark’s hibernation. What matters, for the purpose of establishing a prima facie case, is whether the mark was in use or not.

*Id.* at 12 (quoting 15 U.S.C. § 1127 (2024)).

- (B) The defendant then attempted to escape the resulting prima facie evidence of abandonment with three

showings of its alleged intent to resume the mark's use, but the court rejected each seriatim. The first was the defendant's attempted sale of the mark, which had taken place prior to the statutory three-year period. *Id.* at 15 (“[The defendant’s] attempt to sell the mark . . . cannot rebut [the plaintiff’s] prima facie case of abandonment absent evidence that [the defendant] carried that intent into the statutory period.”). The defendant's second showing of its putative intent to resume using its mark was a settlement agreement with its lender, pursuant to which the lender released a lien on the mark; rather than preventing the mark's use, the court pointed out, the lien only allowed the lender to apply profits from the mark's use to the defendant's unsatisfied debts, and, in any case, “the record contains no evidence indicating that [the defendant] in fact intended to resume use of the mark before or after it became free of the [lender’s] encumbrance.” *Id.* at 16. The defendant's third showing was a license with a third party, which failed to get the job done because it had been executed outside of the statutory period and because the defendant's failure to control the quality of the goods offered under it rendered it invalid as impermissibly nude. *Id.* at 17–19.

- ii. The Fourth Circuit confirmed that a mark owner can rebut the prima facie evidence of abandonment represented by three years' of nonuse of its mark under Section 45 of the Act, 15 U.S.C. § 1127. *See Simply Wireless, Inc. v. T-Mobile US, Inc.*, 115 F.4th 266 (4th Cir. 2024), *cert. denied*, No. 24-367, 2025 WL 1020361 (U.S. Apr. 7, 2025). The mark owner in question accomplished that feat—at least for purposes of securing a vacatur of a summary judgment order against it—through evidence and testimony that it had engaged in negotiations with a potential partner during the initial three-year period of nonuse and that it had resumed using its mark outside that period. *Id.* at 283–85.
- iii. As have many tribunals before it, a New York federal district court confirmed that a litigant unable to demonstrate the discontinuance of a mark's use is in a uniquely poor position to establish the mark's abandonment through nonuse. *See Lion-Aire Corp. v. Lion Air Installation, Inc.*, 747 F. Supp. 3d 488 (E.D.N.Y. 2024). As the court explained, “where, as here, Defendants cannot prove non-use of Plain-

tiff's marks by clear and convincing evidence, summary judgment in favor of Plaintiff is appropriate." *Id.* at 506.

**b. Abandonment Through Naked Licensing**

- i. The First Circuit affirmed a finding of a naked license as a matter of law in a case in which the defendant, "a defunct chicken seller," which had not used its mark in more than four years sought to rehabilitate its rights to the mark by issuing a license to a third party. *See To-Ricos, Ltd. v. Productos Avicolas Del Sur, Inc.*, 118 F.4th 1 (1st Cir. 2024). The license granted the defendant the contractual right to inspect the licensee's products, but the court deemed it more significant that the licensor had neither inspected those products nor received any reports on their quality. Holding that "[u]nder the modern rule, the question is whether there has been sufficient *actual* control by the trademark owner-licensor over the nature and quality of the goods or services sold by the licensee," *id.* at 19 (quoting 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18:48 (5th ed.)), the court characterized the defendant's "contractual right to control" as "'secondary' to the fact that [the defendant] exercised no actual control over [the licensee's] products." *Id.* (quoting McCarthy, *supra*, § 18:48). The court next rejected the defendant's attempted reliance on federal health regulations because, in its view, "[t]hose generally applicable regulations do not assure consumers that they can expect a specific quality from [the licensed] chicken on a consistent basis." *Id.* Finally, it found the defendant's claim of a familial relationship between the principals of the defendant and its licensee because of the absence of any proof that those individuals previously had enjoyed a close working relationship. *Id.*
- ii. One court rejecting a different claim of naked licensing explained that:

[A]bandonment by "naked licensing" occurs when a party allows others "to use the mark without exercising reasonable control over the nature and quality of the goods, services, or business on which the [mark] is used by the licensee." The focus of the naked licensing inquiry is on the "quality control" exercised over the underlying good protected by the mark.

*SonicSolutions Algae Control, LLC v. Diversified Power Int'l, LLC*, 722 F. Supp. 3d 16, 51 (D. Mass. 2024) (citation omitted) (quoting *Blake v. Pro. Coin Grading Serv.*, 898 F. Supp. 2d 365, 385 n.13 (D. Mass. 2012)). Because the counterclaim defendant before the court had failed to adduce any evidence or testimony calling the ability of the counterclaim plaintiff to control the nature and quality of goods sold to which the counterclaim plaintiff's marks were affixed, the court found the claim of naked licensing at issue meritless as a matter of law. *Id.*

## 2. Descriptive Fair Use

### a. One court explained that:

Generally, the fair use defense provides that a junior user is always entitled to use a descriptive term in good faith in its primary, descriptive sense other than as a trademark. The elements of the classic fair use defense are that the defendant (1) is not using the term as a trademark, (2) uses the term only to describe its goods and services, and (3) uses the term fairly and in good faith.

*Jacobsen Outdoor Grp. v. Rocky Mountain Hunting Calls & Supplies, LLC*, No. 2:23-CV-00088-AKB, 2025 WL 315905, at \*12 (D. Idaho Jan. 24, 2025) (citation omitted). Having restated the relevant test in this manner, the court then concluded that the defendant was ineligible for the defense because its challenged use was as a trademark. *Id.*

- b. As always, defendants' invitations to find descriptive fair use at the pleadings stage of cases on motions to dismiss generally fell short. *See, e.g., Videri, Inc. v. ONAWHIM (OAW) Inc.*, No. 1:23-CV-2535-GHW, 2024 WL 4027980, at \*15 (S.D.N.Y. Sept. 3, 2024); *Residential Energy Servs. Network, Inc. v. Bldg. Sci. Inst. Co.*, No. 3:22-CV-1641-AGS-MSB, 2024 WL 4008765, at \*2 (S.D. Cal. Aug. 30, 2024).
- c. Nevertheless, an unpublished Ninth Circuit affirmed the dismissal of a complaint for failure to state a claim, concluding that "[t]aking [the plaintiff's] allegations as true, the classic fair use defense is apparent on the face of [the] Complaint and exhibits incorporated therein." *Skydiving Sch., Inc. v. GoJump Am., LLC*, No. 24-1822, 2025 WL 502491, at \*2 (9th Cir. Feb. 14, 2025).



### 3. Nominative Fair Use

- a. Lacking controlling authority from the Eighth Circuit, a Minnesota federal district court held that a defendant's claim of nominative fair use should be resolved through an application of the standard multifactor test for likely confusion coupled with the Ninth Circuit's three *New Kids on the Block* factors, namely:

(1) whether "the product or service in question" is "one not readily identifiable without use of the trademark"; (2) whether "only so much of the mark or marks" is "used as is reasonably necessary to identify the product or service"; (3) whether the user did anything "that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder."

*Abbott Lab's v. Revitalyte LLC*, 744 F. Supp. 3d 894, 903 (D. Minn. 2024) (quoting *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992)). It did so in a case brought by the owner of the PEDIALYTE mark for "an affordable treatment for mild to moderate dehydration, especially for children who are more prone to catching gastrointestinal illnesses." *Id.* at 897. The plaintiff accused the defendant of promoting its REVITALYTE mark for an adult rehydration product through various uses of the PEDIALYTE mark, including "Compare to Pedialyte" references, *id.* at 899, advertising featuring "various tweets of consumers talking about how embarrassing it was to have to go to the baby aisle to purchase Pedialyte when they were hungover," *id.*, and the retweeting of "comments referring to Revitalyte as 'the adult version of Pedialyte,' 'like Pedialyte but for adults,' 'barstool sports Pedialyte,' 'barstool sports brand [P]edialyte,' 'barstool sports branded [P]edialyte,' and 'Barstool [P]edialyte.'" *Id.* Claiming nominative fair use, the defendant sought to prevail on a motion for judgment on the pleadings, but the court declined to grant that relief. Not only did the plaintiff's complaint aver the existence of actual confusion caused by the defendant's promotion tactics, but "[the plaintiff] has put forth allegations that [the defendant], in conjunction with using the Pedialyte mark on its labeling, has acted in a way that suggests sponsorship and endorsement by [the plaintiff]." *Id.* at 903. The plaintiff's case therefore survived until the proof stage of the litigation.

- b. Similarly lacking guidance from the Seventh Circuit, an Illinois federal district court held that nominative fair use is an affirmative defense, rather than something to be overcome as part of a plaintiff's prima facie case for infringement. *See KTM AG v. Individuals*,

*Corps., Ltd. Liab. Cos., Partnerships, & Unincorporated Ass'ns Identified on Schedule A Hereto*, No. 24-CV-03278, 2025 WL 965130, at \*2 (N.D. Ill. Mar. 31, 2025). “To assert the nominative fair use defense,” it continued, “the alleged infringer must show that: 1) the product in question is not readily identifiable without use of the trademark; 2) only so much of the mark is used as reasonably necessary to identify the product; and 3) the user of the mark did nothing that would suggest sponsorship by the trademark holder.” *Id.* (quoting *Slep-Tone Ent. Corp. v. Coyne*, 41 F. Supp. 3d 707, 717 (N.D. Ill. 2014)). Without an extensive discussion of the challenged uses, the court denied a nominative-fair-use-based motion to dismiss, concluding that the fact-intensive nature of the inquiry precluded its resolution as a matter of law at the pleadings stage of the case. *Id.*

## **B. Equitable Defenses**

### **1. Laches**

- a. Courts applied tests for the affirmative defense of laches over the past year that differed in form, although not in substance.
  - i. For example, some courts adopted a two-part definition requiring showings of: (1) a lack of diligence on the plaintiff's part; and (2) prejudice to the defendant. *See, e.g., PNC Fin. Servs. Grp. v. Plaid Inc.*, No. 2:20-CV-1977, 2024 WL 3687956, at \*14 (W.D. Pa. Aug. 7, 2024).
  - ii. Others, however, adopted a three-part test, which required a party raising a laches defense to prove: (1) a delay in asserting a right or a claim; (2) that the delay was not excusable; and (3) that there was undue prejudice to the party against whom the claim is asserted. *See, e.g., Empower Fed. Credit Union v. Empower Annuity Ins. Co. of Am.*, No. 5:23-CV-941 (BKS/MJK), 2024 WL 3639440, at \*16 (N.D.N.Y. Aug. 2, 2024).
  - iii. Finally, courts in the Ninth Circuit applied that jurisdiction's complex test for laches:

First, courts are to analyze the timeliness of the plaintiffs suit relative to the analogous state law statute of limitations; based on that analysis, a court determines whether laches presumptively applies. “Second, we assess the equity of applying laches using . . . the [following] factors: (1) strength and value of

trademark rights asserted; (2) plaintiff's diligence in enforcing mark; (3) harm to senior user if relief denied; (4) good faith ignorance by junior user; (5) competition between senior and junior users; and (6) extent of harm suffered by junior user because of senior user's delay."

*M.I.B. Grp. v. Aguilar*, No. 5:23-CV-01597-SVW-SHK, 2024 WL 3857540, at \*15 (C.D. Cal. July 16, 2024) (citation omitted) (quoting *Ramirez v. Navarro*, No. 23-55112, 2024 WL 1874993, at \*2 (9th Cir. Apr. 30, 2024)), *appeal docketed*, No. 24-5032 (9th Cir. Aug. 16, 2024); *accord Sw. MFG. LLC v. Wilmar LLC*, No. CV 22-8541-MWF (PDX), 2024 WL 3718371, at \*14 (C.D. Cal. July 16, 2024).

- b. As always, federal courts entertaining claims of laches by defendants referred to statutes of limitations for corresponding state-law torts as benchmarks for determining whether plaintiffs had delayed too long in bringing suit: If they did for longer than the applicable statute of limitations, their claims were presumptively barred by laches; otherwise, the contrary was true. *See, e.g., M.I.B. Grp. v. Aguilar*, No. 5:23-CV-01597-SVW-SHK, 2024 WL 3857540, at \*15 (C.D. Cal. July 16, 2024) (four years under California law), *appeal docketed*, No. 24-5032 (9th Cir. Aug. 16, 2024); *D.H. Pace Co. v. OGD Equip. Co.*, No. 1:20-CV-410-TCB, 2024 WL 3551123, at \*13 (N.D. Ga. May 30, 2024) (four years under Georgia law).
- c. A Hawaii federal district court confirmed that, if laches bars a plaintiff's claim of direct liability for false advertising, it necessary bars a claim of contributory liability for the same tort. *See Haw. Foodservice All., LLC v. Meadow Gold Dairies Haw., LLC*, 736 F. Supp. 3d 909, 918–19 (D. Haw. 2024).

## 2. Acquiescence

- a. A Georgia federal district court held that:

"The defense of acquiescence requires proof of three elements: (1) the plaintiff actively represented it would not assert a right or claim; (2) the delay between the active representation and assertion of the right or claim was not excusable; and (3) the delay caused the defendant undue prejudice." "The distinguishing feature of the acquiescence defense is the

element of *active* or *explicit* consent to the use of an allegedly infringing mark.”

*D.H. Pace Co. v. OGD Equip. Co.*, No. 1:20-CV-410-TCB, 2024 WL 3551123, at \*14 (N.D. Ga. May 30, 2024) (first quoting *Angel Flight of Ga., Inc. v. Angel Flight Am., Inc.*, 522 F.3d 1200, 1207 (11th Cir. 2008) (citation omitted); and then quoting *SunAmerica Corp. v. Sun Life Assurance Co. of Can.*, 77 F.3d 1325, 1344 (11th Cir. 1996)). Consistent with judicial practice in the laches context, it then held that, because the plaintiff had asserted an infringement claims within the statute of limitations for the corresponding state tort, the claims was timely as a matter of law. *Id.* at 14–15.

- b. A Maryland federal district court confirmed that, as with all other affirmative defenses, an assertion of acquiescence must be supported by at least some factual allegations. *See Freedom Servs., Inc. v. Freedom Servs., LLC*, No. CV MJM-23-1625, 2024 WL 3089663, at \*8 (D. Md. June 21, 2024) (granting motion to dismiss).

### 3. Unclean Hands

- a. One court held that “[t]he application of unclean hands is appropriate ‘where the party applying for such relief is guilty of conduct involving fraud, deceit, unconscionability, or bad faith related to the matter at issue to the detriment of the other party.’” *Empower Fed. Credit Union v. Empower Annuity Ins. Co. of Am.*, No. 5:23-CV-941 (BKS/MJK), 2024 WL 3639440, at \*16 (N.D.N.Y. Aug. 2, 2024) (quoting *Jackpocket, Inc. v. Lottomatrix NY LLC*, 645 F. Supp. 3d 185, 276 (S.D.N.Y. 2022), *aff’d*, No. 23-12-cv, 2024 WL 1152520, (2d Cir. Mar. 18, 2024)). It did so in a case in which the defendant accused the plaintiff of having rebranded itself in a manner increasing the likelihood of confusion between the parties and their services. That accusation, the court concluded, was sufficient to state a claim of unclean hands as an affirmative defense. *Id.* at \*16. The court did, however, disallow a different claim of unclean hands by the defendant (not described by the court in any detail) after concluding that it depended on communications between the parties during settlement communications. *Id.* at \*17–18.
- b. Another court held that “[t]he doctrine of unclean hands permits courts ‘to deny injunctive relief where the party applying for such relief is guilty of conduct involving fraud, deceit, unconscionability, or bad faith related to the matter at issue to the detriment of the other party.’” *FBB IP LLC v. Big Boy Rest. Grp.*, No. 1:25-CV-95, 2025 WL 732297, at \*4 (S.D. Ohio Mar. 7, 2025) (quoting *Performance Unlimited, Inc. v. Questar Publishers, Inc.*, 52 F.3d 1373,

1383 (6th Cir. 1995)). In the litigation producing that restatement, the defendant accused the plaintiff of various acts of misconduct, but those alleged acts did not include any bearing on the plaintiff's acquisition of rights to the marks on which the plaintiff relied. *Id.* That omission doomed the defendant's claim that unclean hands necessarily precluded the plaintiff from prevailing.

- c. The Federal Circuit took issue with a suggestion by the Trademark Trial and Appeal Board that unclean hands is unavailable as an affirmative defense against an allegation of functionality. *See CeramTec GmbH v. Coorstek Bioceramics LLC*, 124 F.4th 1358, 1368 (Fed. Cir. 2025). Nevertheless, it also held that any error inherent in that suggestion was moot in light of the Board's consideration of the defense anyway. *Id.*

#### 4. Trademark Bullying

- a. The Trademark Trial and Appeal Board's nonprecedential case law historically has not treated alleged bullying by mark owners as a cognizable affirmative defense, especially if the party claiming bullying fails to support that claim with alleged facts rising to the level of unclean hands. *See Tex. Lottery Comm'n v. Ansari*, No. 91264107, 2022 WL 1421561, at \*1 (T.T.A.B. Apr. 18, 2022) (nonprecedential) ("Trademark bullying is not a cognizable affirmative defense in inter partes proceedings before the Board, but unclean hands is."); *Imagewear Apparel Corp. v. Majestic Roar*, No. 91218736, 2015 WL 9906657, at \*2 (T.T.A.B. Nov. 6, 2015) (nonprecedential) ("Applicant . . . alleges that Opposer is engaging in 'trade-mark bullying . . . to harass and intimidate other businesses beyond what the law might reasonably be interpreted to allow.' However, no such defense exists. Rather, trademark owners are entitled to protect rights in their registered trademarks by seeking to preclude registration of what they believe to be confusingly similar marks." (second alteration in original)).
- b. In *DoorDash, Inc. v. Greenerside Holdings, LLC*, 2024 U.S.P.Q.2d 935 (T.T.A.B. 2024), the Board adopted that position as a matter of its precedential case law. It therefore struck the applicant's assertion of bullying as an affirmative defense with the observation that:

In this instance, Opposer pleads likelihood of confusion based on its registrations and is . . . merely exercising its right to protect its marks. A defense, as with any pleading, must contain sufficient factual matter to give rise to a particular defense. There must be more than threadbare recitals supported by conclusory statements. Applicant's

mere characterization of Opposer’s prior opposition activity as “bullying,” or assertion of “dubious, weak or exaggerated” claims, does not constitute a sufficient allegation of facts to support an unclean hands defense.

*Id.* at \*2 (citations omitted).

- c. The Board subsequently reiterated that conclusion, albeit in dictum, in *Monster Energy Co. v. Jones*, 2024 U.S.P.Q.2d 1697 (T.T.A.B. 2024), in which it warned litigants that “registrants are permitted to protect their rights in their registered marks and to plead likelihood of confusion to preclude the registration of what they believe to be confusingly similar marks.” *Id.* at \*3 n.18.

## VI. REMEDIES

### A. Injunctive Relief

1. In a false advertising action between sellers of organic hemp rolling papers, the Seventh Circuit affirmed entry of a permanent injunction requiring that the defendant’s advertising or promotional statements “shall either clearly constitute permissible opinion (e.g., that something is ‘great tasting’) or be factual statements for which [the defendant] maintains tangible, objective, verification.” *Republic Techs. (NA), LLC v. BBK Tobacco & Foods, LLP*, No. 23-2973, 2025 WL 1201401, at \*9 (7th Cir. Apr. 25, 2025). As the court of appeals explained:

Courts regularly differentiate between statements of opinion and fact when assessing false advertising claims, as well as claims in other areas of the law. Likewise, businesses must ordinarily ensure that their advertisements are factually accurate. This injunction is “sufficiently definite” because it reflects that legal reality. It simply adds some requirements—like maintaining factual verification—to ensure that [the defendant] complies with the law.

*Id.* at \*10 (citations omitted).

2. Consistent with the text of Section 34(a) of the Lanham Act, 15 U.S.C. § 1116(a) (2024), courts recognized a presumption of irreparable harm in cases presenting violations of the Act. *See, e.g., City of N.Y. by & through FDNY v. Henriquez*, No. 22-CV-3190 (KAM) (PK), 2025 WL 542782, at \*3 (E.D.N.Y. Feb. 19, 2025) (“In trademark cases, a showing of likelihood of confusion as to source or sponsorship establishes the requisite likelihood of success on the merits as well as risk of irreparable harm.” (quoting *Am. Cyanamid Co. v. Campagna Per Le Farmacie in Italia, S.P.A.*, 847 F.2d 53, 55 (2d Cir. 1988))), *appeal docketed*, No. 25-641 (2d Cir. March

19, 2025); *Crye Precision LLC v. Concealed Carrier, LLC*, 749 F. Supp. 3d 308, 334 (E.D.N.Y. 2024) (“[I]f the plaintiff demonstrates both the validity of its mark and a likelihood of confusion, and the defendant fails to rebut the presumption, the plaintiff satisfies its burden of showing irreparable harm.”). As one court explained, “[t]his statutory presumption accounts for the unique nature of trademarks and the difficulty in calculating the cost of their infringement.” *FBB IP LLC v. Big Boy Rest. Grp.*, No. 1:25-CV-95, 2025 WL 732297, at \*9 (S.D. Ohio Mar. 7, 2025).

3. Although otherwise affirming a preliminary injunction against a splinter group of dissenting members using the LIBERTARIAN PARTY service mark in the face of objections from the Libertarian National Committee, the Sixth Circuit rather inexplicably them allowed to continue fundraising using the mark so long as they employed disclaimers of affiliation. *See Libertarian Nat’l Comm., Inc. v. Saliba*, 116 F.4th 530, 540 (6th Cir. 2024).

## **B. Monetary Relief**

### **1. Actual Damages**

- a. Section 35(a) of the Lanham Act provides that “[i]n assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. . . . Such sum in either of the above circumstances shall constitute compensation and not a penalty.” 15 U.S.C. § 1117(a) (2024). In one appeal to the Third Circuit in which that provision came into play, the district court increased a compensatory award by a jury from \$142,000 to \$426,000, citing in part the jury’s finding that the defendant had willfully infringed the plaintiff’s marks. *See Lontex Corp. v. Nike, Inc.*, 107 F.4th 139 (3d Cir. 2024). Not surprisingly, the defendant challenged that augmentation by arguing in part that the district court had acted with an impermissible punitive intent. The court of appeals was unmoved, noting that the profits enjoyed by the defendant’s misconduct well exceeded the plaintiff’s actual damages. That consideration, the court held, justified the increased award, even if the district court’s focus on the defendant’s willfulness did not. *Id.* at 156.
- b. One court confirmed that a decline in a plaintiff’s revenues will not support an award of actual damages if the plaintiff cannot demonstrate a nexus between that decline and the defendant’s unlawful conduct. *See Sw. MFG. LLC v. Wilmar LLC*, No. CV 22-8541-MWF (PDX), 2024 WL 3718371, at \*12 (C.D. Cal. July 16, 2024).

## 2. Statutory Damages

- a. The Eleventh Circuit affirmed an award of \$123,000 in statutory damages per nine marks counterfeited by the defendants for a total of \$1,107,000. *See Top Tobacco, L.P. v. Star Imps. & Wholesalers, Inc.*, No. 24-10765, 2025 WL 1248707 (11th Cir. Apr. 30, 2025). In doing so, it rejected three challenges to the award on appeal, namely, that the award: (1) was impermissibly larger than the plaintiff's demonstrated actual damages, *id.* at \*3–4; (2) was unlawful because it imposed statutory damages for punishment and deterrence even though the jury found no willfulness, *id.* at \*4–5; and (3) violated the defendants' right to due process. *Id.* at \*5–6.
- b. An ambitious claim for statutory damages totaling \$650,000,000 against nine individual defendants fell short at the hands of a New York federal district court. *See Christian Dior Couture SA v. Lin*, 744 F. Supp. 3d 312 (S.D.N.Y. 2024). In balking at that amount while granting the plaintiffs' motion for summary judgment, the court considered the following factors: (1) the expenses saved and the profits reaped by the defendants; (2) the revenues lost by the plaintiff; (3) the value of the plaintiffs' marks; (4) the deterrent effect of any award on third parties; (5) whether the defendants' conduct was willful or innocent; (6) the degree of the defendants' conduct in providing records from which the value of their infringements could be determined; and (7) the deterrent effect on the defendants themselves. *Id.* at 316. The court's application of those factors worked to the plaintiffs' disadvantage, in part because of their investigators' failure to document the exact prices at which the defendants had sold their unlawful goods; an additional problem from the court's perspective was the unlikelihood of purchasers of the defendants' goods buying legitimate products from the plaintiffs had the defendants' goods been unavailable. *Id.* Moreover, even through the value of the plaintiffs' marks was high, and the defendants' misconduct willful, "the defendants are street sellers, mostly selling the counterfeit goods on the sidewalk or out of cars. They are not shown to be manufacturers or high-level producers of these goods." *Id.* at 317.
- c. Albeit in a default judgment, another court awarded the prevailing plaintiff \$180,000.00 per trademark counterfeited per type of good offered for sale and/or sold by the defendant. *See Chanel, Inc. v. 21948352*, No. 0:24-CV-62446, 2025 WL 741827, at \*6 (S.D. Fla. Mar. 7, 2025).



### 3. Accountings of Profits

- a. In an opinion ultimately vacated and remanded by the Supreme Court, the Fourth Circuit affirmed an expansive accounting of profits by a North Carolina federal district court. *See Dewberry Eng'rs Inc. v. Dewberry Grp.*, 77 F.4th 265 (4th Cir. 2023), *vacated and remanded*, 145 S. Ct. 681 (2025). It did so in a case in which the prevailing plaintiff's complaint targeted only a single defendant (a commercial real estate developer) but in which the court of appeals affirmed an accounting that considered the profits of several affiliates of that defendant without actually ordering those affiliates to disgorge their profits by, for example, piercing the corporate veil between them and the actual defendant.
- i. Addressing the question of the plaintiff's entitlement to that remedy in the first instance, the court applied a six-factor test, which considered: "(1) whether the defendant had the intent to confuse or deceive, (2) whether sales have been diverted, (3) the adequacy of other remedies, (4) any unreasonable delay by the plaintiff in asserting his rights, (5) the public interest in making the misconduct unprofitable, and (6) whether it is a case of palming off." *Id.* at 289 (quoting *Synergistic Int'l, LLC v. Korman*, 470 F.3d 162, 175 (4th Cir. 2006)). There was no dispute in the appellate record that the defendant's infringement had not resulted in diverted sales and that the defendant had not passed off its services as those of the plaintiff. At the same time, however, the defendant had ignored "several 'red flags' cautioning against its conduct, namely, its admission in earlier negotiations between the parties of the confusing similarity of the marks at issue, the plaintiff's demand letters, and the USPTO's rejection of an application to register one of the defendant's marks based on a perceived likelihood of confusion with one of the plaintiff's marks. *Id.* In addition to those factors, as well as evidence and testimony establishing the court considered the damage allegedly caused to the plaintiff's brand equity by the defendant's infringement, *id.* at 290, something that might ordinarily come into play in a calculation of the plaintiff's actual damages.
- ii. With respect to the mechanics of the resulting accounting, the defendant argued it did not actually provide services under its infringing marks to other parties for a profit. Instead, it allegedly produced infringing branding for its affiliates, who in turn generated profits using that branding on their lease, loan, and other promotional materials; indeed, the defendant's tax returns showed it operated at a loss.

That attempted distinction between the defendant and its affiliates failed to impress the court, which focused on the fact that the defendant and its affiliates were ultimately owned by the same individual, who, like the defendant's affiliates, was not himself a named defendant. Although the plaintiff apparently had made no effort to pierce the corporate veil between the defendant and its affiliates, the court held that equitable nature of the accounting remedy obviated the need for such a nicety. "Rather than pierce the corporate veil," it explained, "the [district] court considered the revenues of entities under common ownership with [the plaintiff] in calculating [the plaintiff's] true financial gain from its infringing activities that necessarily involved those affiliates." *Id.* at 292. Specifically:

A district court's grant of profit disgorgement is "subject to the principles of equity," and is ultimately a matter of the court's discretion. The district court here "weigh[ed] the equities of the dispute and exercise[d] its discretion" to hold [the defendant] to account for the revenues generated in part from infringing materials used by its affiliates under common ownership. Admonishing courts for using their discretion in this fashion risks handing potential trademark infringers the blueprint for using corporate formalities to insulate their infringement from financial consequences. That, of course, runs counter to Congress's fundamental desire to give trademark registrants under the Lanham Act "the greatest protection that can be given them."

*Id.* at 293 (first and second alterations in original) (first quoting 15 U.S.C. § 1117(a) (2024); then quoting *Synergistic Int'l*, 470 F.3d at 176; and then quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985)).

- iii. The court then reviewed the actual quantum of the accounting ordered by the district court. Apparently—but perhaps understandably—not anticipating that it would be required to disgorge profits in an amount to those of its non-party affiliates, the defendant did not introduce evidence or testimony of those companies' deductible costs. That led the district court to discount the affiliates' revenues (as calculated by an expert witness retained by the plaintiff) by

twenty percent “to account for pre-existing leases and revenues that theoretically might not have had any relation to the infringing activities.” *Id.* at 293. The defendant objected to that discount as speculative, but the court of appeals rejected that criticism by holding that “[a]ny arbitrariness . . . can be traced back to [the defendant’s] litigation strategy to deny any connection between its affiliates’ revenues and its infringing marks.” *Id.* As far it as concerned, “[the defendant] offered *no* calculations for costs, nor did it provide calculations reflecting the distinction between infringing and non-infringing revenues. It was [the defendant’s] burden to provide this evidence, and we will not now fault the district court for the approximations it was forced to make.” *Id.*

iv. At the end of the day, the result was the disgorgement of \$42,975,725.60, enforceable against the single named defendant but *not* against the affiliates of the defendant that had actually enjoyed those profits. *Id.* at 291. Possibly motivated by either the quantum of that accounting or the district court’s methodology in reaching it, the Supreme Court subsequently granted a petition for writ of certiorari to the Fourth Circuit. The single question presented by that petition and the alternative question proffered by the plaintiff in its response to the petition demonstrate the deep divide between the parties’ understanding of the relief affirmed by the Fourth Circuit.

(A) According to the defendant, the appropriate question is “[w]hether an award of the ‘defendant’s profits’ under [Section 35(a) of] the Lanham Act, can include an order for the defendant to disgorge the distinct profits of legally separate non-party corporate affiliates.” Petition for Certiorari at (i), *Dewberry Grp. v. Dewberry Eng’rs*, 145 S. Ct. 681 (2025) (No. 23-900).

(B) According to the plaintiff, however, the Court properly should consider “[w]hether a district court’s discretion under the Lanham Act permits using the financial statements of ‘non-arms’ length’ affiliates to adjust a disgorgement award against a trademark infringer, and only that infringer, when the infringer has claimed \$0 in profits.” Brief in Opposition to Petition for Certiorari at (i), *Dewberry Grp. v. Dewberry Eng’rs*, 145 S. Ct. 681 (2025) (No. 23-900).

- v. The Court sided with the defendant in a unanimous opinion vacating the Fourth Circuit’s order and remanding the action. *See Dewberry Grp. v. Dewberry Eng’rs*, 145 S. Ct. 681 (2025). It noted that Section 35(a) authorized accountings of the profits of a “defendant,” which the Court defined as “the party against whom relief or recovery is sought in an action or suit.” *Id.* at 687. Applying that definition to the case before it, the Court held that “[t]he plaintiff] chose not to add the [defendant’s] affiliates as defendants. Accordingly, the affiliates’ profits are not the (statutorily disgorgable) ‘defendant’s profits’ as ordinarily understood.” *Id.* at 686. Because the plaintiff additionally had never attempted to pierce the corporate veil between the defendant and its affiliates, that meant “the ‘defendant’s profits’ are the *defendant’s* profits, not its plus its affiliates’.” *Id.*
- vi. The Court next addressed the plaintiff’s argument that Section 35(a)’s equitable grant of flexibility— “[i]f the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case,” 15 U.S.C. § 1117(a)—authorized the district court’s consideration of the affiliates’ profits when arriving at a “just sum” once it had determined the defendant’s actual profits. The flaw in that argument, the Court held, was that “[t]he District Court did not rely on the just-sum provision, or suggest that it was departing up from [the defendant’s] reported profits to reflect the company’s true gain,” *Dewberry Grp.*, 145 S. Ct. at 687; moreover, the same was true of the Fourth Circuit’s affirmance, which had also inappropriately ignored the distinction between the defendant and its separately incorporated affiliates. “By treating those entities as one and the same,” the Court concluded, “the courts below approved an award including *non*-defendants’ profits—and thus went further than the Lanham Act permits.” *Id.* at 688. Significantly, however, the Court preemptively ruled out neither an application of the plaintiff’s proposed “just sum” methodology nor corporate veil-piercing on remand. *Id.*
- b. The Seventh Circuit confirmed that a prevailing plaintiff seeking an accounting of profits need not itself demonstrate the quantum of those profits. *See Dyson Tech. Ltd. v. David 7 Store*, 132 F.4th 526 (7th Cir. 2025). The district court assigned to the case declined to enter the relief requested by the plaintiff, explaining that “[t]he Court declines the request to award profits because Plaintiff offered evidence of revenue, not profits. Revenue and profits are not

the same thing. The Court declines the invitation to assume that all of the revenue equals profits.” *Id.* at 528. Consistent with the express text of Section 35(a), 15 U.S.C. § 1124(a) (2024), the Seventh Circuit held on appeal that:

The district court contravened the Lanham Act’s plain language when it found [the plaintiff’s] evidence of revenue as opposed to profits insufficient and declined to assume that revenue equals profits. The Act presumes that the infringing defendant’s sales (that is, revenue) and profits *are* the same thing, until the defendant proves otherwise. . . . A trademark plaintiff need not disentangle revenue and profits. This rule may well result in a windfall to the trademark holder, but that is a price worth paying—a principle the Supreme Court established eighty years ago.

*Dyson Tech.*, 132 F.4th at 529 (citing *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 207 (1942)). Like the Supreme Court in *Dewberry*, the court pointed out that the district court enjoyed the ability to make equitable adjustments to an accounting to reach a just sum; the problem, the court pointed out, was that the district court had failed to exercise that authority when refusing to enter the accounting. *Id.*

#### 4. Attorneys’ Fees

- a. Pursuant to Section 35(a) of the Lanham Act, 15 U.S.C. § 1117(a), awards of attorneys’ fees in litigation under the Lanham Act are possible in an “exceptional case,” which increasingly means in most jurisdictions that the case “stands out from others with respect to the substantive strength of a party’s litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.” *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 554 (2014). Despite the Third Circuit’s prior adoption of that standard, *see Fair Wind Sailing, Inc. v. Dempster*, 764 F.3d 303, 314–15 (3d Cir. 2014), a New Jersey federal district court granted the fee petition of a prevailing defendant by citing three considerations of its own making, namely: (1) the importance of enforcing trademark rights; (2) the “David vs. Goliath” nature of the litigation; and (3) the expense of trademark litigation. *See Lontex Corp. v. Nike, Inc.*, 107 F.4th 139, 157 (3d Cir. 2024). Criticizing the district court’s reliance on “broad policy considerations rather than facts specific to this case,” *id.*, the court of appeals vacated and remanded the fee award for an application of the *Octane Fitness* test. In

doing so, it observed that “while the behavior of the parties during litigation may be relevant, the [district] [c]ourt should avoid extralegal assessment of the parties’ sizes and financial resources as standalone indicators of exceptionality.” *Id.* at 158.

- b. The Fifth Circuit similarly concluded that a district court had abused its discretion in ordering reimbursement of the fees incurred by a plaintiff in successfully demonstrating its opponent had infringed its service mark. *See Appliance Liquidation Outlet, L.L.C. v. Axis Supply Corp.*, 105 F.4th 362 (5th Cir. 2024). “In explaining its fee award,” the appellate court observed, “the district court made no finding that [the defendant] had a subjective belief that it was guilty of trademark infringement or that it had acted with the specific intent to cause confusion.” *Id.* at 384. Instead, the district court had grounded its fee award in the defendant’s: (1) allegedly willful infringement; (2) refusal to settle; and (3) abandonment of its infringing mark on the eve of trial. *Id.* at 385 (“Other circuits have refused to find willful infringement in the context of [Section 35(a)] where a party refuses to change its mark after receiving a cease-and-desist letter or being made party to a lawsuit. That authority is persuasive.” (footnote omitted)). The first of those justifications, however, failed because it rested only on the defendant’s continued use of its mark after learning of the plaintiff’s objections. The second was likewise deficient, as “[i]f a court cannot use the threat of sanction to force a settlement offer, it follows that it may not impose sanctions on a party for failing to engage in settlement negotiations when that party has legitimate defenses to litigate.” *Id.* “Finally,” the court concluded, “the fact that [the defendant] changed its [usage] on the eve of trial cannot support the fee award because there was no evidence that [the plaintiff] had an improper motivation for waiting that long to make the change.” *Id.* at 385–86. The resulting absence of evidence supporting an inference of bad faith by the defendant mandated a reversal of the district court’s imposition of fees. *Id.* at 386.

## VII. CONSTITUTIONAL ISSUES

### A. The First Amendment

1. The test for liability first set forth in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), has played an increasingly significant role in trademark-based challenges to the titles and content of creative or expressive works since its articulation. Although applications of that test vary from court to court, the test generally requires plaintiffs to demonstrate that challenged imitations of the plaintiff’s mark either have no artistic relevance to the underlying creative work or, if they do have any artistic relevance, they are explicitly misleading. *Id.* at 999. A plaintiff before a court that has adopted

*Rogers* must also demonstrate that confusion is likely, whether as a standalone showing (as in the Ninth Circuit) or as part of the inquiry into whether the defendant's use is explicitly misleading (as in the Second Circuit). Compare *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265 (9th Cir. 2018) ("If the plaintiff satisfies both elements, it still must prove that its trademark has been infringed by showing that the defendant's use of the mark is likely to cause confusion.") with *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) ("This determination must be made, in the first instance, by application of the venerable *Polaroid* [likelihood-of-confusion] factors."). As the Supreme Court held in *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023), however, *Rogers* is unavailable if a defendant's use of an alleged imitation of a plaintiff's mark is as a designation of source for the defendant's own goods or services. *Id.* at 153, 155–56.

- a. In *Jack Daniel's* itself, Jack Daniel's previously had demonstrated in a circa-2017 bench trial that confusion was likely between its marks and trade dress and the counterclaim defendant's "Bad Spaniel's" imitations of them. On remand from the Supreme Court's opinion, however, and following additional briefing by the parties, the district court amended its findings of fact and conclusions of law following the original trial to find confusion *unlikely*. See *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, No. CV-14-02057-PHX-SMM, 2025 WL 275909 (D. Ariz. Jan. 23, 2025). The court explained of that finding that:

"Bad Spaniels" need not contain some message of ridicule directed at Jack Daniel's in order to succeed as a parody product. "Bad Spaniels" must instead create contrasts between it and Jack Daniel's trademarks by way of a humorous message achievable "by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner." Based upon these criteria, the Court must conclude that "Bad Spaniels" achieves this juxtaposition.

*VIP Prods. LLC v. Jack Daniel's Props. Inc.*, No. CV-14-02057-PHX-SMM, 2025 WL 275909, at \*21 (D. Ariz. Jan. 23, 2025).

- b. Addressing a question left open—but increasingly answered in the affirmative—by *Jack Daniel's*, a California federal district court held that *Rogers* survives in cases in which defendants' uses are not in the nature of trademark ones. See *Haas Automation, Inc. v. Steiner*, 750 F. Supp. 3d 1107, 1118 (C.D. Cal. 2024) ("Defendants' use of the marks is subject to the *Rogers* test because Defendants

do not use the [plaintiff's] [m]arks as marks.”), *appeal docketed*, No. 24-6344 (9th Cir. Oct. 17, 2024).

- c. Nevertheless, *Rogers* was not a get-out-of-jail-free card for all defendants. The plaintiffs in a case against the generative AI platform Midjourney alleged that the latter’s CEO had posted a list identifying 4,700 artists whose styles Midjourney could emulate and also that their names were used in connection with Midjourney’s “showcase” of works generated on the platform. *See Andersen v. Stability AI Ltd.*, 744 F. Supp. 3d 956 (N.D. Cal. 2024). Midjourney responded to the complaint with a motion to dismiss grounded in the *Rogers* test, but the court proved unreceptive to it, observing that “[o]pen questions also remain whether Midjourney promoting its product for commercial gain for use by others to create artistic images is *itself* expressive use that creates “artistic relevance” to plaintiffs’ underlying works. Discovery may show that it is or that is it not.” *Id.* at 978 (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013)).

- 2. The *Rogers* framework was not the only First Amendment-related issue to attract Supreme Court attention, and, indeed, the Court used a different one altogether in *Vidal v. Elster*, 602 U.S. 286 (2024).

- a. *Elster* arose from an application to register the TRUMP TOO SMALL mark for various shirts:



As the Federal Circuit explained, “the phrase he sought to trademark [sic] invokes a memorable exchange between President Trump and Senator Marco Rubio from a 2016 presidential primary debate, and aims to ‘convey[ ] that some features of President Trump and his policies are diminutive.’” *In re Elster*, 26 F.4th 132 (Fed. Cir. 2022) (“*Elster I*”), *rev’d sub nom. Vidal v. Elster*, 602 U.S. 286 (2024) (*Elster II*). The USPTO denied registration to the mark under Section 2(c) of the Act, which mandates the refusal of any application to register a mark that “[c]onsists of or comprises a



name . . . identifying a particular living individual” without the individual’s written consent. 15 U.S.C. § 1052(c) (2024).

- b. The Federal Circuit reversed the Trademark Trial and Appeal Board’s affirmance of the refusal.
  - i. It initially determined that determined that, in contrast to the prohibitions against registration at issue in *Matal v. Tam*, 582 U.S. 218 (2017), and *Iancu v. Brunetti*, 588 U.S. 388 (2019), Section 2(c) had a content-discriminatory, instead of a viewpoint-discriminatory effect. That determination, it noted, opened the door to one of two tests for evaluating Section 2(c)’s constitutionality.
    - (A) The first of those tests was that originating in *R.A.V. v. St. Paul*, 505 U.S. 377 (1992), which, in its current form, holds that “[c]ontent-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.” *Reed v. Town of Gilbert, Ariz.*, 576 U.S. 155, 163 (2015). The Supreme Court has characterized that test as one of strict scrutiny in at least one opinion, see *Brown v. Ent. Merchants Ass’n*, 564 U.S. 786, 799 (2011), but it also has recognized that there are at least some scenarios in which content-based regulations of speech do not warrant that level of scrutiny. See *Davenport v. Washington Educ. Ass’n*, 551 U.S. 177, 188–89 (2007).
    - (B) The second possible test was that found in *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980), which holds that content-based regulation of commercial speech not encouraging illegal activity is disfavored but possibly can be justified under intermediate scrutiny, if the asserted government interest is substantial, the regulation directly advances that government interest, and the regulation is no more extensive than necessary. *Id.* at 562–66.
  - ii. The court ultimately deemed it unnecessary to decide between the two approaches. Instead, it held, “[w]hatever the standard for First Amendment review of viewpoint-neutral, content-based restrictions in the trademark area, whether strict scrutiny, there must be at least a substantial govern-

ment interest in the restriction.” *Elster I*, 26 F.4th at 1333–34 (citations omitted). According to the USPTO, there were two such substantial interests, which were the protection of the former president’s state-law rights of privacy and publicity. Addressing the former right, the court held there could be no “no plausible claim” that the former president enjoyed a right of privacy “protecting him from criticism in the absence of actual malice—the publication of false information ‘with knowledge of its falsity or in reckless disregard of the truth.’” *Id.* at 1335 (quoting *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967)). With the USPTO unable to identify supporting judicial authority (or even scholarship) recognizing such an interest, and in the absence of claim of actual malice on the applicant’s part, Section 2(c)’s prohibition on registration could not rest on a right-of-privacy foundation. The USPTO’s asserted interest in protecting the former president’s right of publicity required a “more complex” analysis, but it also fell short of the mark: Although the government might have the ability under *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987), to regulate conduct potentially lessening the distinctiveness and value of another’s mark, even in the absence of likely confusion, “[n]o similar claim is made here that President Trump’s name is being misappropriated in a manner that exploits his commercial interests or dilutes the commercial value of his name, an existing trademark, or some other form of intellectual property.” *Elster I*, 26 F.4th at 1336. Moreover, and in any case, “[t]he right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent.” *Id.* at 1337. Section 2(c) therefore was unconstitutional on at least an as-applied basis “under any conceivable standard of review.” *Id.* at 1339.

iii. With the court rejecting the government’s proffered interests in vindicating Trump’s rights of publicity and privacy, *id.* at 1335–39, the court held Section 2(c) unconstitutional on an as-applied basis, holding that “[t]he PTO’s refusal to register [the] mark cannot be sustained because the government does not have a privacy or publicity interest in restricting speech critical of government officials or public figures in the trademark context—at least absent actual malice, which is not alleged here.” *Id.* at 1339.

c. Agreeing to review the Federal Circuit’s invalidation of Section 2(c), the Supreme Court granted the government’s petition for a writ of certiorari, which presented the following question: “Wheth-

er the refusal to register a mark . . . violates the Free Speech Clause of the First Amendment when the mark contains criticism of a government official or public figure.” Petition for Certiorari at (I), *Vidal v. Elster*, 602 U.S. 286 (2024) (U.S. June 13, 2024) (No. 22-704). The Court answered that question in an opinion authored by Justice Thomas, which, as a threshold matter, agreed with the Federal Circuit’s conclusion that Section 2(c)—referred to by the Court as the “names clause”—had a content-discriminatory effect, but not a viewpoint-discriminatory one.

- i. Citing the USPTO’s practice of refusing registration to applied-for marks containing any recognizable references to living individuals, the Court explained that “the names clause does not facially discriminate against any viewpoint. No matter the message a registrant wants to convey, the names clause prohibits marks that use another person’s name without consent. It does not matter ‘whether the use of [the] name is flattering, critical or neutral.’” *Elster II*, 602 U.S. at 294 (alteration in original) (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 13:37.50 (5th ed.)).
- ii. Having reached that conclusion, the Court improbably did not mention, much less apply, one of its two traditional frameworks for weighing the constitutionality of content-based restrictions on commercial speech, namely, that found in *Central Hudson*. In contrast, and “[a]s a general matter,” it invoked the *Reed*. framework by observing that “a content-based regulation is ‘presumptively unconstitutional and may be justified only if the government proves that [it is] narrowly tailored to serve compelling state interests.’” *Id.* at 293 (second alteration in original) (quoting *Nat’l Inst. of Family & Life Advocates v. Becerra*, 585 U.S. 755, 766 (2018)). Despite invoking the latter framework, however, the Court did not apply it.
- iii. Instead, it undertook a historical analysis of trademark law generally and trademark law’s treatment of claimed rights in personal names in particular. That led the Court ultimately to conclude that “[s]everal features of trademark [law] counsel against a *per se* rule of applying heightened scrutiny to viewpoint-neutral, but content-based trademark regulations.” *Id.* at 295. One such feature, the Court held, was “the inherently content-based nature of trademark law,” which “has never been a cause for constitutional concern.” *Id.* at 296. As evidence of that nature, the Court cited to the common-law’s discouragement of claims of rights to per-

sonal names, which it considered to be codified in the Lanham Act in form of Section 2(e)(4)’s prohibition on the registration of applied-for marks deemed to be primarily merely surnames without supporting showings of secondary meaning. *Id.* at 304 (citing 15 U.S.C. § 1052(e)(4) (2024)). The Court also found support for its conclusion in the common-law cause of action for infringement recognized by both English courts and their early United States counterparts, which, it noted, extended to alleged misappropriations of personal names. *Id.* at 306. “[P]olicing trademarks so as to prevent confusion over the source of goods,” it explained, “requires looking to the mark’s content.” *Id.* at 300. Thus, “[t]he common law did . . . allow a person to obtain a trademark *containing* his own name—with a caveat: A person could not use a mark containing his name to the exclusion of a person with the *same* name.” *Id.* at 302. So too did the Court take a different view from the Federal Circuit of its past decision in *San Francisco Arts & Athletics*, which the Court held stood for the proposition that “a party has no First Amendment right to piggyback off the goodwill another entity has built in its name,” *id.* at 306; “[t]he names clause,” it concluded, “guards a similar interest.” *Id.* at 307.

- iv. The result of the Court’s deep dive into the history of trademark law was that Section 2(c) withstood constitutional scrutiny:

We conclude that a tradition of restricting the trademarking [sic] of names has coexisted with the First Amendment, and the names clause fits within that tradition. Though the particulars of the doctrine have shifted over time, the consistent through line is that a person generally had a claim only to his own name. The names clause reflects this common-law tradition by prohibiting a person from obtaining a trademark of another living person’s name without consent, thereby protecting the other’s reputation and goodwill.

*Id.*; see also *id.* at 308 (“[T]he names clause is of a piece with a common-law tradition regarding the trademarking of names. We see no reason to disturb this longstanding tradition, which supports the restriction of the use of another’s name in a trademark.”). The Court took pains, however, to limit the scope of its holding to Section 2(c), holding that:

Our decision today is narrow. We do not set forth a comprehensive framework for judging whether all content-based but viewpoint-neutral trademark restrictions are constitutional. Nor do we suggest that an equivalent history and tradition is required to uphold every content-based trademark restriction. We hold only that history and tradition establish that the particular restriction before us, the names clause in [Section 2(c)], does not violate the First Amendment. Although an occasion may arise when history and tradition cannot alone answer whether a trademark restriction violates the First Amendment, that occasion is not today.

*Id.* at 310.

v. There were several concurring opinions, most notably those from Justices Barrett and Sotomayor.

(A) Justice Barrett’s concurrence was joined by Justice Kagan and in part by Justices Sotomayor and Jackson. Barrett took issue with the Court’s conclusion that history and tradition settled the issue of Section 2(c)’s constitutionality, therefore rendering it unnecessary to adopt a standard for gauging whether that section or other content-based prohibitions on registration abridged the right to free speech. Justice Barrett considered that conclusion “wrong twice over,” *id.* at 311, observing that, “[f]irst, the Court’s evidence, consisting of loosely related cases from the late-19th and early-20th centuries, does not establish a historical analogue for the names clause. Second, the Court never explains why hunting for historical forebears on a restriction-by-restriction basis is the right way to analyze the constitutional question.” *Id.* She therefore would adopt an alternative test for evaluating the constitutionality of restrictions on registrability:

Content-based criteria for trademark registration do not abridge the right to free speech so long as they reasonably relate to the preservation of the markowner’s goodwill and the prevention of consumer con-

fusion. A particular restriction will serve those goals if it helps ensure that registered marks actually function as source identifiers.

*Id.* at 318.

- (B) Justice Sotomayor would have taken a similar approach. Her opinion concurring in the judgment argued that:

The most straightforward way to resolve this and other free-speech challenges to trademark registration criteria is through a doctrinal framework drawn from this Court's First Amendment precedent. The analysis should proceed in two steps. First ask whether the challenged provision targets particular views taken by speakers on a given subject. If the trademark registration bar is viewpoint based, it is presumptively unconstitutional and heightened scrutiny applies; if it is viewpoint neutral, however, the trademark registration bar need only be reasonable in light of the purpose of the trademark system. Specifically, the trademark registration bar must reasonably serve its purpose of identifying and distinguishing goods for the public. If the challenged provision is both viewpoint neutral and reasonable, then it does not violate the Free Speech Clause.

*Id.* at 329 (Sotomayor, J., concurring in judgment).

3. Although the Supreme Court in *Jack Daniel's* reversed the Ninth Circuit's dismissal of Jack Daniel's claim for likely dilution by tarnishment, it did so purely as a matter of statutory interpretation; in other words, no First Amendment considerations came into play. *Id.* at 161–62. On remand, the counterclaim defendant successfully invoked Rule 5.1 of the Federal Rules of Civil Procedure, FED. R. CIV. P. 5.1, which requires district courts to certify to the Attorney General of the United States any constitutional challenges to federal statutes and allow the United States to intervene if it

so chooses. On April 10, 2024, the district court therefore certified to the Attorney General the following question:

Does the Lanham Act provision authorizing injunctive relief in cases of trademark dilution by tarnishment, 15 U.S.C. § 1125(c)(2)(C), violate the First Amendment to the United States Constitution because its reliance on whether the trademark use “harms the reputation of the famous mark” constitutes impermissible viewpoint discrimination?

*VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, No. CV-14-02057-PHX-SMM, slip op. at 4 (D. Ariz. Apr. 10, 2024). Ultimately, however, the court held that the counterclaim defendant had waived its First Amendment challenge to Jack Daniel’s likely-dilution-by tarnishment cause of action by failing to aver that challenge in its pleadings. *See VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, No. CV-14-02057-PHX-SMM, 2025 WL 275909, at \*15 (D. Ariz. Jan. 23, 2025) (“[The counterclaim defendant’s] constitutional challenge is not properly before the Court because it is not raised in ([the counterclaim defendant’s] pleadings, and the Court declines to consider the merits of it at this time.”).

## **B. The Seventh Amendment**

The Seventh Amendment provides that “[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.” U.S. CONST. amend. VII. Its scope has been a recurring subject of litigation in trademark and unfair competition in recent years.

1. Addressing a question of first impression for it, the Eighth Circuit held that a plaintiff cannot pursue a jury trial if the only monetary relief at issue is the equitable remedy of an accounting of profits. *See Nat’l Presto Indus. v. U.S. Merchants Fin. Grp.*, 121 F.4th 671 (8th Cir. 2024). In doing so, the court rejected the argument that, if a plaintiff cannot prove its entitlement to the legal remedy of an award of actual damages, that inability renders an accounting a legal remedy as well:

[P]roving actual damages caused by trade dress infringement can be difficult. The Lanham Act permits a plaintiff to recover the infringing defendant’s profits without having to prove causation. This does not make the remedy legal under the established Seventh Amendment analysis. Courts have long exercised equitable jurisdiction in “[t]he absence of a plain and adequate remedy at law.” We decline to construe an equitable remedy as legal *because* the legal remedy

may have been unavailable, when the inadequacy of legal remedies is the *raison d'être* of equitable jurisdiction.

*Id.* at 680 (quoting *Watson v. Sutherland*, 72 U.S. 74, 79 (1866)).

2. A Georgia federal district court reached much the same conclusion in holding that “the Seventh Amendment right to trial by jury does not apply where the plaintiff asserts remedies for disgorgement of profits and attorney’s fees.” *Smoothie King Franchises, Inc. v. Best Smoothie, Inc.*, No. 1:21-CV-04402-WMR, 2024 WL 5104536, at \*2 (N.D. Ga. Nov. 15, 2024).
3. In contrast, the Seventh Circuit held that there was “no question” a plaintiff before it had a constitutional right to a jury trial on its request for punitive damages under Illinois law. *See Curry v. Revolution Lab’ys, LLC*, 124 F.4th 441, 451 (7th Cir. 2024).

## VIII. USPTO PRACTICE

### A. Substantive Questions of Registrability

1. Not for the first time, the Board muddled the procedural waters en route to a finding that an intent-to-use application was void for want of the required bona fide under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b) (2025). *See Tequila Cuadra S. de RL de CV v. Manufacturera de Botas Cuadra, S.A. de C.V.*, 2025 U.S.P.Q.2d 729 (T.T.A.B. 2025).

- a. The Board framed the parties’ respective burdens in the following manner:

“Opposer has the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods [on the filing date of its application].” “The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof sufficient to prove that the applicant lacks a bona fide intention to its use its mark in commerce.” If an opposer establishes a prima facie case, the burden shifts to the applicant to rebut that prima facie case by producing evidence which would establish that it had the requisite bona fide intent to use the mark when it filed its application.

*Id.* at (first quoting *Boston Red Sox Baseball Club LP v. Sherman*, 88 U.S.P.Q.2d 1581, 1587 (T.T.A.B. 2008); and then quoting *id.*)



- b. If an opposer already has proven an absence of the required bona fide intent to use by a preponderance of the evidence, however, it is not apparent why an applicant's mere production of evidence of such an intent would allow it to prevail. Indeed, no less an authority than the Supreme Court has held that if a plaintiff bears the burden of proving a particular fact, requiring the defendant to disprove that fact as an affirmative defense is an illogical legal *non sequitur*. As the Court explained in the trademark case of *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004):

If a plaintiff succeeds in making out a prima facie case . . . , the defendant may offer rebutting evidence to undercut the force of the plaintiff's evidence . . . or raise an affirmative defense to bar relief even if the prima facie case is sound, or do both. But it would make no sense to give the defendant a defense of showing affirmatively that the plaintiff cannot succeed in proving some element [of its case]; all the defendant needs to do is to leave the factfinder unpersuaded that the plaintiff has carried its own burden on that point.

*Id.* at 120. Requiring a defendant to produce documentary evidence of an intent to use after the plaintiff has proven the nonexistence of that same documentary evidence is just as dubious as that disapproved of in *KP Permanent Make-Up*.

2. In *General Cigar Co. v. Empresa Cubana Del Tabaco*, No. 1:23-CV-227 (LMB/WEF), 2025 WL 1333227 (E.D. Va. May 7, 2025), a Virginia federal district court dismissed for failure to state a claim a challenge to the Trademark Trial and Appeal Board's cancellation of two registrations under Article 8 of the General Inter-American Convention for Trade-mark and Commercial Protection, under which a petitioner for cancellation of a registration generally must prove that: (1) it enjoyed legal protection for its marks in a party to the treaty before the priority date of the registration; and (2) the respondent knew of the petitioner's rights in that country prior to adopting its marks in the United States. *Id.* at \*3. The petitioner carried its burden under each prong, leading the respondent to argue to the district court that the implementing regulations for the Cuban Liberty and Democratic Solidarity (LIBERTAD) Act, Pub. L. No. 104–114, 110 Stat. 785 (1996), barred the Cuba-based petitioner from pursuing the action. The court rejected that argument, on concluding instead that the cancellation of the registrations at issue did not constitute an impermissible transfer of assets under the LIBERTAD Act but instead fell within an administrative exception to the Act allowing for transactions “related to the registration and renewal” of registrations in the USPTO. *Gen. Cigar Co.*, 2025 WL 1333227, at \*14 (citing 31 C.F.R. §§ 515.27(a)(1) (2025)).

3. In *In re Locus Link USA*, 2024 U.S.P.Q.2d 1181 (T.T.A.B. 2024), the Trademark Trial and Appeal Board issued its first substantive application of the ex parte mechanisms enacted by the Trademark Modernization Act for invalidating registrations. The mechanism at issue was expungement, or, in other words, a challenge to two registrations based on the argument that the underlying marks had ever been used in commerce. The Director of the USPTO found that the registrant had failed to rebut the petitioner’s prima facie case of nonuse, and the Board affirmed. Both registrations covered “components for air conditioning and cooling systems, namely, evaporative air coolers,” but the Board found the goods were actually connectors instead of evaporative air coolers. *Id.* at \*4–5. It therefore affirmed the invalidation of both registrations.
4. Despite the Federal Circuit’s adoption of a strict test for fraud on the USPTO in *In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009), courts and the Board alike continue to be tasked with evaluations of claims of fraudulent filings before the Board.
  - a. The Board confirmed that “intent to deceive can be inferred from recklessness, in particular a reckless disregard for the truth.” *Look Cycle Int’l v. Kunshan Qiyue Outdoor Sports Goods Co.*, 2024 U.S.P.Q.2d 1424, at \*12 (T.T.A.B. 2024). In applying that standard, it reached a finding of fraud based on numerous irregularities in the respondent’s claim of actual use of its mark in commerce in the United States, including: (1) the use of the British spelling “tyres”; and (2) alleged shipments of goods under the mark to non-existent addresses. *Id.* at \*12–14.
  - b. In contrast, a New York federal district court rejected as a matter of law a claim of fraudulent procurement grounded in the theory that the counterclaim defendant’s LION-AIRE mark for HVAC services was not used in commerce at the time the counterclaim defendant secured two use-based registrations of the mark. *See Lion-Aire Corp. v. Lion Air Installation, Inc.*, 747 F. Supp. 3d 488 (E.D.N.Y. 2024). As partial support for that theory, the counterclaim plaintiffs called the court’s attention to a screenshot from the counterclaim defendant’s website showing what the counterclaim plaintiffs claimed were “miniscule references” to the LION-AIRE marks. The counterclaim defendant had submitted the same screenshot as a specimen supporting each of its challenged registrations, though, which led the court to grant summary judgment to the counterclaim defendant with the observation that:

In its trademark application[s], [the counterclaim defendant] submitted to the USPTO the very screenshot of its website that [the counterclaim plaintiffs] contend proves [the counterclaim defend-

ant’s] application[s] [were] fraudulent. It is incomprehensible to the Court, and would be incomprehensible to a jury, that a plaintiff could knowingly mislead” the USPTO about whether it used its marks in commerce while simultaneously disclosing to the USPTO the precise manner in which it was using its marks in commerce. Even if its website expressed [the counterclaim defendant’s] intent to no longer use the Lion-Aire mark[] in commerce, which it patently did not, that fact would have been disclosed to the USPTO via the submission of the screenshot of the website. Thus, there was no misstatement of fact “that would have affected the [USPTO’s] action on the application in question.”

*Id.* at 480 (eighth alteration in original) (quoting *A.V.E.L.A., Inc. v. Est. of Marilyn Monroe, LLC*, 241 F. Supp. 3d 461, 480 (S.D.N.Y. 2017)).

5. Section 2(b) prohibits the registration of marks “[c]onsist[ing] of or compris[ing] the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 U.S.C. § 1052(b) (2024). Unusually, the past year saw an application of that prohibition by a federal district court in a case in which the plaintiff challenged registrations covering the following marks, the first of which was owned by the United States Marine Corps and the second and third of which were owned by the United States Army:



*See Shields of Strength v. U.S. Dep’t of Def.*, 735 F. Supp. 3d 755, 777–78 (E.D. Tex. 2024). Sued along with the Department of Defense, the defendants sought the dismissal of the plaintiff’s challenges to their registrations

in part on the theory that the marks at issue did not qualify as “insignia[s] of the United States” within the meaning of Section 2(b). According to the defendants, that phrase swept in marks of “national significance,” which the defendants defined as “the Great Seal of the United States, the Presidential Seal, and seals of governmental departments), as opposed to marks that identify particular people or agencies within a department of the executive branch (such as the Marine Corps or a particular division of the Army).” *Id.* at 778. In a scholarly analysis of the history of Section 2(b) and its predecessors, the court disagreed, holding instead that insignias of the United States were “marks identifying a person or group of people with the authority or power of the United States government.” *Id.* The plaintiff’s challenge therefore survived the pleadings stage of the case: “Each of the three marks whose registrability [the plaintiff] . . . contest[s] under [Section 2(b)] is plausibly alleged to be a mark identifying a person or group with the authority or power of the federal government. [The plaintiff] thus states a legally viable claim for relief as to those marks.” *Id.* at 783.

6. In a question of first impression, the Board unsurprisingly concluded that Section 2(a)’s prohibition on the registration of marks “falsely suggest[ing] a connection with persons, living or dead, institutions, beliefs, or national symbols,” 15 U.S.C. § 1052(a) (2024), applies to collective membership marks. It did so in *In re Leathernecks Motorcycle Club Int’l, Inc.*, 2024 U.S.P.Q.2d 1023 (T.T.A.B. 2024), in which it affirmed the refusal of an application to register the following mark for membership in a motorcycle club, which the Board found falsely suggested a connection to the United States Marine Corps:



7. In a different opinion arising from the refusal of an application under Section 2(a)’s false suggestion of a connection prong, the Federal Circuit confirmed that the USPTO and the Trademark Trial and Appeal Board could consider evidence bearing on the issue postdating the filing date of the application at issue. *See In re Foster*, No. 2023-1527, 2025 WL 1317602, at \*2 (Fed. Cir. May 7, 2025) (“[W]e hold § 2(a) bars registration of a pending application for a mark that falsely suggests a connection as of the time of examination. The false connection inquiry can therefore include evidence that comes into existence during the examination process.”). It reached that holding en route to an affirmance of the Board’s finding that the applied-for US SPACE FORCE mark for various goods and services falsely suggested a connection with the federal government’s U.S. Space Force military branch. That outcome held even though the applicant’s fil-

ing date predated both the announcement of the formation of the U.S. Space Force and congressional authorization of it.

8. In *State Permits, Inc. v. Fieldvine, Inc.*, 2024 U.S.P.Q.2d 1458 (T.T.A.B. 2024), the Board confirmed that a petitioner for the cancellation of a registration on the Supplemental Register covering a mark lacking secondary meaning can prevail by merely establishing prior use—a showing that its own mark has secondary meaning is unnecessary. *Id.* at \*9 (“[I]f Respondent has not demonstrated that [its mark] has acquired distinctiveness, Petitioner need only prove that it is the prior user . . . to prevail on its likelihood of confusion claim.”).

## **B. Registration-Related Procedural Issues**

1. In *NHDNC LLC v. Velcro BVBA*, 2024 U.S.P.Q.2d 1600 (T.T.A.B. 2024), the Board bifurcated a cancellation proceeding into two parts, one addressing the petitioner’s entitlement to a statutory cause of action, and, if necessary, the other addressing the merits of the petition’s challenge to the validity of the respondent’s registered marks.
2. In *Luca McDermott Catena Gift Trust v. Fructuoso-Hobbs SL*, 102 F.4th 1314 (Fed. Cir. 2024), the Federal Circuit affirmed a finding that a limited partner in a California-based winery was not entitled to challenge to assert a likelihood-of-confusion-based challenge to registrations of marks owned by another winery. Addressing the question using the test for Article III standing set forth in *Lexmark International, Inc. v. Static Control Components, Inc.*, 572 U.S. 118 (2014), the court determined that the limited partner had sufficiently averred an injury redressable by the registrations’ cancellation, but it balked at the limited partner’s claim to lie within the zone of interests protected by the Section 2(d) of the Act, 15 U.S.C. § 1052(d), because of his minority stake in its winery. *Luca McDermott Catena Gift Tr.*, 102 F.4th at 1326–27. The court then rejected the limited partner’s claim of proximate causation because the limited partner’s claim of damage was merely derivative of damage suffered by the winery in which it was a limited partner. *Id.* at 1327.
3. In contrast, the Board in *Plumrose Holding Ltd. v. USA Ham LLC*, 2025 U.S.P.Q.2d 116 (T.T.A.B. 2025), held that a Venezuelan opposer could assert a cause of action for misrepresentation of source under Section 14(3) of the Act, 15 U.S.C. § 1064(3), despite its apparent inability to demonstrate use in commerce of the mark it sought to protect. The key to the opposer’s success at the trial of the matter was proof that the mark enjoyed a reputation in the United States and that the defendant’s imitation of it was linked to that reputation. *Id.* at \*3–10.
4. The Board took a dim view of a request for leave to file an amicus brief by a law school intellectual property and technology law clinic. *See Monster*

*Energy Co. v. Jones*, 2024 U.S.P.Q.2d 1697 (T.T.A.B. 2024). Because the Board denied the motion, the proposed brief does not appear on the docket of the opposition for which it was prepared, but the would-be amicus apparently was not so much a friend of *the Board* as it was a friend of *a party*, namely, the applicant. The Board found in a withering treatment of the issue that “[the] proposed brief is replete with partisan argument, and otherwise does not aid us in resolving any ‘doubtful’ issues of law.” *Id.* at \*3. Specifically, the brief: (1) addressed issues within the Board’s expertise and adequately briefed by the parties; (2) sought to portray the opposer as a trademark bully, an accusation the Board viewed as irrelevant unless the opposer’s conduct somehow constituted unclean hands; (3) inappropriately sought to have the opposer sanctioned and the registrations on which it relied canceled. *Id.* at \*3–4.

5. With a respondent’s registration having been automatically cancelled because of the respondent’s failure to file the declaration of ongoing use required by Section 8 of the Lanham Act, 15 U.S.C. § 1058 (2024), the Board not surprisingly dismissed a cancellation action against the registration as moot. *See Men’s Wearhouse, LLC v. WKND NYC LLC*, 2024 U.S.P.Q.2d 86, at \*3 (T.T.A.B. 2024).
6. Consistent with that outcome, the Board held in another cancellation action that, if the six-month grace period expires for the filing of a Section 8 declaration of ongoing use, the registration at issue is cancelled as a matter of law as of the last day of the sixth year following registration. *See Retrobrands Am. LLC v. Molson Coors Beverage Co. USA LLC*, 2024 U.S.P.Q.2d 769 (T.T.A.B. 2024).
7. The Board declined to reach a holding of claim preclusion (or res judicata) in *Hollywood Casinos, LLC v. Zarco Hotels Inc.*, 2024 U.S.P.Q.2d 985 (T.T.A.B. 2024). In that case, the parties had previously been engaged in an opposition proceeding in which the opposer (the same party in both cases) had alleged a likelihood of confusion between the parties’ marks; the opposer also unsuccessfully attempted to assert a geographic descriptiveness challenge, only to have the Board conclude that the opposer had failed to assert that claim on a timely basis. Because the Board found that the applicant (also the same party in both cases) did not own the applied-for mark, it entered judgment in the opposer’s favor on that basis, without resolving the opposer’s other challenges to the applied-for mark’s registrability. That disposition led the applicant to assert claim preclusion with respect to those challenges when the opposer asserted them in a second opposition against a new application to register the same mark. The Board rejected that assertion, even though the opposer relied in the second opposition on registrations and common-law rights it had not invoked in the original one. *Id.* at \*7 (“Because Opposers’ original likelihood of confusion claim is not extinguished, Opposers’ amended likelihood of confusion claim based upon their additional registrations and common law rights that

could have been raised in the Prior Opposition also is not extinguished. There is no reason why claim preclusion would apply to only the latter claim and not the former.”).

8. In *Mountain Gateway Order, Inc. v. Virginia Community College System*, 2024 U.S.P.Q.2d 1025 (T.T.A.B. 2024), the Board tackled the question of whether a state agency applying for registration can assert sovereign immunity as a defense to an opposition proceeding against its application. It answered that question in the negative.
9. The Board is not a fan of summary motions, but it granted one in light of a litigant’s failure to respond to case-dispositive requests for admission. See *Learning Journey Int’l, L.L.C. v. Hua Yongfu*, 2024 U.S.P.Q.2d 1609 (T.T.A.B. 2024).
10. The Board confirmed that a plaintiff wishing to assert rights to a family of marks must do so in its complaint and that a failure to do will preclude such an assertion later unless the defendant consents to it. See *Heil Co. v. Tripleye GmbH*, 2024 U.S.P.Q.2d 2010 (T.T.A.B. 2024).